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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91171726
Party	Defendant Crown Confectionary, Co., Ltd.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MORINAGA & CO., LTD.)	
)	
Opposer/Registrant,)	
)	
v.)	Opposition No. 91171726
)	
CROWN CONFECTIONARY CO., LTD.)	
)	
Applicant.)	
)	
)	

APPLICANT’S MAIN BRIEF

Applicant Crown Confectionary Co., Ltd. (“Applicant”) hereby files its main Brief, responding to Opposer’s Trial Brief, and asserts that the opposition brought against registration of Applicant’s MYCHEW (stylized) mark by Opposer Morinaga & Co., Ltd. (“Opposer”) based on likelihood of confusion should be denied by the Trademark Trial and Appeal Board.

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I. DESCRIPTION OF THE RECORD

OPPOSER'S EVIDENCE

- A. The pleadings and the file history of the subject application
1. First Pleaded Registration in Par. 3 of Notice of Opposition
Reg. No. 2626396 for “candy” in Class 30



2. Second Pleaded Registration in Par. 3 of Notice of Opposition
Reg. No. Reg. No. 3097367 originally for “Biscuits, chocolates, caramels, snack foods consisting of chocolate, grain, nuts, dried fruit, rice, soya flour, wheat, cereals, maize, potato flour and soft candy, cakes, ice cream, cocoa, hotcake mix, candy, and gum, namely chewing gum and bubble gum” at time of filing of opposition, but currently only for “candy” in Class 30¹



3. First Application set forth in Par. 3 of Notice of Opposition
Ser. No. 78523925 (now Reg. No. 3325869) originally for “Biscuits; chocolate; caramel; snacks, namely, cereal based snacks; candy; chewing gum; frozen confectioneries; cake paste; cookie; nougat” at time of filing of opposition, but currently only for “candy” in Class 30²



(with “FRUIT CHEWS” disclaimed).

¹ Opposer’s Reg. No. 3097367 was registered on May 30, 2006 for “Biscuits, chocolates, caramels, snack foods consisting of chocolate, grain, nuts, dried fruit, rice, soya flour, wheat, cereals, maize, potato flour and soft candy, cakes, ice cream, cocoa, hotcake mix, candy, and gum, namely chewing gum and bubble gum.” Mr. Shimada admitted in his deposition dated April 22, 2009 that Opposer had never used this mark in connection with any goods other than “candy.” [Shimada Dep. ¶¶ 20(a) ~ 20(o)]. Opposer then filed a Section 7 Request on May 26, 2009, deleting all goods from the registration except “candy,” with the declaration for the Request (filed later) signed by Mr. Shimada.

² Opposer’s Reg. No. 3325869 was registered on October 30, 2007 for “Biscuits; chocolate; caramel; snacks, namely, cereal based snacks; candy; chewing gum; frozen confectioneries; cake paste; cookie; nougat.” Mr. Shimada admitted in his deposition dated April 22, 2009 that Opposer had never used this mark in connection with any goods other than “candy.” [Shimada Dep. ¶¶ 20(a) ~ 20(o)]. Opposer then filed a Section 7 Request on May 26, 2009, deleting all goods from the registration except “candy,” with the declaration for the Request (filed later) signed by Mr. Shimada.

4. Second Application set forth in Par. 3 of Notice of Opposition Ser. No. Ser. No. 78523930 (now Reg. No. 3181707) originally for “Biscuits; chocolate; caramel; snacks, namely, soy based snacks, cereal based snacks; candy; chewing gum; frozen confectioneries; cake paste; cookie; nougat” at time of filing of opposition, but currently only for “candy” in Class 30³



(with “FRUIT CHEWS” disclaimed).

- B. Opposer’s Testimonial Deposition on Written Questions of Mr. Tetsuo Shimada, including Exhibits A-J (“Shimada Dep.”)
- C. Opposer’s Notice of Reliance, including Exhibits A-I (“Opp.’s NOR”)

APPLICANT’S EVIDENCE

- A. **The pleadings and the file history of the subject application.**
- B. **Applicant’s First Corrected Notice of Reliance** (“App.’s Corr. First NOR”)
1. **Exhibit A:** Merriam-Webster’s Collegiate Dictionary, Eleventh Edition (Merriam-Webster’s, Inc. 2005)
 - a) Definition of “CHEW”: Definition 1: 1: to crush, grind, or gnaw (as food) with or as if with the teeth ... — **chewable** *adj.* ... **chewy** *adj.* Definition 2: 1: ... 2: something for chewing.
 - b) Definition of “HI”: *interj* – used esp. as a greeting
 - c) Definition of “MY”: 1: of or relating to me or myself esp. as possessor agent, object of an action, or familiar person <~ car><~ injuries><~man> 2: — used interjectionally to express surprise and sometimes reduplicated <~ oh ~> ...
 2. **Exhibit B:** Explanations and Illustrations of the “Romanization” of the Japanese Language
 - a) **Exhibit B1:** Pocket Kenkyusha Japanese Dictionary (Oxford University Press 2003)
 - b) **Exhibit B2:** Basic Japanese-English Dictionary , Second Edition (Oxford University Press and Bonjinsha 2004)
 - c) **Exhibit B3:** Webster’s New World Compact Japanese Dictionary, Revised Edition (Wiley Publishing, Inc., 1997)

³ Opposer’s Reg. No. 3181707 was registered on December 5, 2006 for “Biscuits; chocolate; caramel; snacks, namely, soy based snacks, cereal based snacks; candy; chewing gum; frozen confectioneries; cake paste; cookie; nougat.” Mr. Shimada admitted in his deposition dated April 22, 2009 that Opposer had never used this mark in connection with any goods other than “candy.” [Shimada Dep. Cross Questions ¶¶ 20(a) ~ 20(o)]. Opposer then filed a Section 7 Request on May 26, 2009, deleting all goods from the registration except “candy,” with the declaration for the Request (filed later) signed by Mr. Shimada.

- d) **Exhibit B4:** Random House Japanese-English English-Japanese Dictionary (Random House Publishing Group and Ballantine Books 1995)
 - e) **Exhibit B5:** Japanese For Busy People (Kodansha International 2006)
3. **Exhibit C:** Applicant’s Discovery Requests and Opposer’s Responses - Interrogatories
- a) **Exhibit C1:** Applicant’s First Set of Interrogatories
 - b) **Exhibit C2**
 - (1) Opposer’s Objections and Responses to Applicant’s First Set of Interrogatories (Redacted) (*accidentally labeled as Exhibit D1*)
 - (2) Opposer’s Objections and Responses to Applicant’s First Set of Interrogatories (Not redacted)
4. **Exhibit D:** Applicant’s Discovery Requests and Opposer’s Responses - Admissions
- a) **Exhibit D1:** Applicant’s First Request for Admissions
 - b) **Exhibit D2:** Opposer’s Objections and Responses to Applicant’s First Request for Admissions
5. **Exhibit E:** Applicant’s Discovery Requests and Opposer’s Responses – Documents
- a) **Exhibit E1:** Applicant’s First Request for Production of Documents and Things (this document should have been labeled as Exhibit E1, but had no label)
 - b) **Exhibit E2:** Opposer’s Objections and Responses to Applicant’s First Request for Production of Documents and Things (this document was accidentally not submitted – however, the documents themselves were, labeled as Exhibit E2, and Opposer did not object)
6. **Exhibit F:** Discovery Requests and Opposer’s Responses – Supplemental Responses
- a) **Exhibit F1:** Supplemental Responses to Applicant’s First Set of Interrogatories – in letter from former attorney for Opposer, Michelle C. Morris, dated October 30, 2007
 - b) **Exhibit F2:** Opposer’s Supplemental Responses to Applicant’s First Set of Interrogatories – dated January 22, 2008
7. **Exhibit G:** Third-Party Registrations
- a) **Exhibit G1:** USPTO TESS Database Search “*CHEW*[BI]” – 1,311 Results
 - b) **Exhibit G2:** USPTO TESS Database Search “(((*CHEW*)) [BI] and (live)[LD] and `RD > 19000000”)[ALL] and (1a)[CB]” – 319

Records⁴

c) **Exhibit G3:** (((*CHEW*)[BI] NOT (`RD > "19000000") [RD] and (030)[IC] and (live)[LD] and (1a)[CB])) [ALL] or (((*CHEW*)[BI] and (`RD > "19000000") [RD] and (030)[IC] and (dead)[LD] and (1a)[CB])) [ALL] – 148 results

C. **Applicant's Second Notice of Reliance**⁵

1. Declaration of translator, Young-Sook Hwang
2. Decision by Soul Central District Court (2004 Gahap 87331)
3. Decision by Korean IP Office (2005 Dang 15)
4. Decision by Korean IP Office (2005 Dang 16)
5. Decision by Korean IP Office (Kor. Opposition No. 40-2004-501136)

⁴ Of the TESS copies and/or specimens of use copies submitted for most the 319 Records returned in this search, 61 were for marks in Class 30; of these 61, 57 TESS copies were submitted; 16 specimens of use in all were submitted (but only 11 were accompanied by a TESS copy (Nos. 7, 11, **12**, 27, **29**, 34, 38, 39*, 42*, 52, 57, 58, 59, 60*, 62, 70, 80, 84, 86, 87*, 90, 102, **103**, 104, 116, 129, 135, 137, 140, **141** [No TESS], 152, 156, 162, 163, 165, 166, **174**, 176, 178, **180**, **192** [No TESS], 193, 197, **221**, **231** [No TESS], 232, 235, **236**, **241**, **246**, 248, 251, **252**, 256, **261** [No TESS], 265, **280**, 284, **285**, **286** [No TESS], 287) [* indicates that a specimen of use was not submitted, even though the chart indicates that one was submitted; bold font indicates that a specimen of use was submitted; underlining indicates that the specimen of use was submitted in TTABVUE No. 57; "No TESS" indicates that a TESS copy was omitted, but that a specimen of use was submitted for the mark]. Of these 61 marks in Class 30, 19 contain the word CHEWY (or CHEWIE or CHEWIES) (7, 11, 34, 38, 52, 62, 135, 137, 140, 152, 162, 163, 165, 166, 176, 197, 248, 251, 287) and 42 contain the wording CHEW (or CHEWS or CHEWING)(12, 27, 29, 39, 42, 57, 58, 59, 60, 70, 80, 84, 86, 87, 90, 102, 103, 104, 116, 129, 141, 156, 174, 178, 180, 192, 193, 221, 231, 231, 235, 236, 241, 246, 252, 256, 261, 265, 280, 284, 285, 286).

⁵ The Description of Record section on page 2 of Opposer's Trial Brief omitted Applicant's Second Notice of Reliance.

II. PRELIMINARY STATEMENT

Applicant contends that the shared portion of Opposer’s Mark and Applicant’s mark, namely, CHEW, is generic or highly descriptive, based on dictionary definitions, third-party registrations, and other evidence, such that the dominant portions of the marks are “HI,” in the case of the Opposer, and “MY,” in the case of the Applicant. Because the shared portion is so weak, and because “HI” and “MY” have distinctive connotations, even to the extent that Opposer has built up goodwill in a “family of marks” with respect to the term “HI,” Applicant respectfully requests that the subject opposition be dismissed.

The marks in question are:



III. ISSUES PRESENTED

(a) Whether the Applicant’s MYCHEW trademark is likely to cause confusion with the Opposer’s Mark?

(b) If so, whether registration to the Applicant should therefore be refused?

IV. FACTUAL BACKGROUND

Applicant's Mark was published for opposition on June 6, 2006, and Opposer timely filed its Notice of Opposition on July 6, 2006. The two parties were well aware of one another prior to the summer of 2006, having engaged in litigation in various countries over issues related to likelihood of confusion between Opposer's Mark (and variations thereof in Japanese and English) and Applicant's Mark (and variations thereof in Japanese and English). In Korea, Opposer lost a trademark infringement case in the Seoul District Court,⁶ two decisions by the Korean IP Office (KIPO) brought by Applicant to negatively confirm the scope of Morinaga's mark based on lack of similarity of the marks,⁷ and an opposition proceeding,⁸ all involving the subject marks. In Japan, Opposer lost an opposition against the MYCHEW mark,⁹ but won an invalidation case against the MYCHEW mark.¹⁰

⁶ *Morinaga & Co., Ltd. v. Crown Confectionary Co., Ltd.*, 2004 Gahap 87331 (Seoul Central District Court 2005)(**ruling in favor of Applicant** in determining that "MYCHEW" and "MYCHEW in Korean letters" were not likely to cause confusion with "HICHEW in Katakana" "HICHEW" and "HI-CHEW," due, in part, to the descriptive nature of the term "CHEW," and in determining that the litigation cost would be borne by Morinaga) [See App.'s Second NOR, first case; Shimada Dep. ¶ 8 – "I do not recall the case number, but I do remember that the opposition and invalidation cases that the Company filed against "MYCHEW" in Korea did not prosper."].

⁷ *Crown Confectionary v. Morinaga & Co., Ltd.*, 2005 Dang 15 (Korean IP Office 2005)(**ruling in favor of Applicant** in determining, in part, that "MYCHEW" (stylized) would not fall under the protective scope of Morinaga's HI-CHEW Mark (same mark in U.S. opposition), and that the litigation cost would be borne by Morinaga) [App.'s Second NOR, second case]; *Crown Confectionary v. Morinaga & Co., Ltd.*, 2005 Dang 15 (Korean IP Office 2005)(**ruling in favor of Applicant** in determining, in part, that "MYCHEW" (stylized) would not fall under the protective scope of Morinaga's HICHEW Mark (in typed font), and that the litigation cost would be borne by Morinaga) [App.'s Second NOR, third case; Shimada Dep. ¶ 8 – "I do not recall the case number, but I do remember that the opposition and invalidation cases that the Company filed against "MYCHEW" in Korea did not prosper."].

⁸ *Morinaga & Co., Ltd. v. Crown Confectionary Co., Ltd.*, Opp. No. 40-2004-501136 (Korean IP Office)(**ruling in favor of Applicant** in determining, in part, that "MYCHEW (and equivalent Korean letters)"(in typed font) was not likely to cause confusion with Morinaga's HICHEW Mark (in typed font), due, in part, to the descriptive nature of the term "CHEW," and in determining that the litigation cost would be borne by Morinaga) [App.'s Second NOR, fourth case; Shimada Dep. ¶ 8 – "I do not recall the case number, but I do remember that the opposition and invalidation cases that the Company filed against "MYCHEW" in Korea did not prosper."].

⁹ See Shimada Dep. ¶ 11 (Mr. Shimada indicating that Morinaga was unable to prevent registration in Japan of the MYCHEW mark in opposition proceeding no. 2005-90 162)].

¹⁰ See Shimada Dep. ¶ 11; Opp.'s NOR Par. (g), and Exhibit I.

During discovery, both parties filed Motions to Compel.¹¹ The Board issued two respective decisions in turn.¹²

On October 14, 2008, the parties filed a joint motion entitled: “Joint Motion for Approval of Stipulation Regarding Manner of Conducting Depositions Upon Written Questions.”¹³ This motion was accompanied by an underlying document entitled: “Stipulated Agreement By Parties Regarding Procedures for Testimonial Depositions Upon Written Questions.” These documents reflected the agreement between the parties to allow testimonial depositions to take place without a court reporter upon written questions and under affidavit. As noted in Opposer’s Brief, Opposer took the testimonial deposition of Mr. Tetsuo Shimada on written questions on April 22, 2009 and filed the deposition (with translation) on May 21, 2009.

On August 14, 2009, Opposer filed its Notice of Reliance. Applicant did not take any testimony, but filed a Notice of Reliance on October 13, 2009. Applicant then filed a document entitled Applicant’s Corrected First Notice of Reliance on October 20, 2009. Applicant filed a Consented Motion For Leave To Accept As Valid Applicant’s Corrected First Notice Of Reliance on December 4, 2009.¹⁴ Applicant’s Motion was granted on December 7, 2009, along with a consented motion that Opposer had requested.

V. EVIDENTIARY CORRECTIONS, EXPLANATIONS, AND ARGUMENTS

A. Evidentiary Corrections

See Evidentiary Appendix

¹¹ Applicant filed its Motion to Compel on September 11, 2007 (TTABVUE No. 19); Opposer filed its Motion to Compel on January 7, 2008 (TTABVUE No. 30).

¹² The Board’s decision regarding Applicant’s Motion to Compel was issued on December 20, 2007 (TTABVUE No. 29); The Board’s decision regarding Opposer’s Motion to Compel was issued on March 10, 2008.

¹³ The Joint Motion is numbered on TTABVUE as TTABVUE No. 36.

¹⁴ See TTABVUE No. 61. In the document, Applicant stated: “Applicant respectfully requests that the Board consider the document entitled “Applicant’s Corrected First Notice of Reliance,” filed on October 20, 2009, as valid and as replacing Applicant’s (First) Notice of Reliance, filed on October 13, 2009. Applicant notes that all of the underlying documents attached to and associated with Applicant’s (First) Notice of Reliance should be considered as attached to and associated with Applicant’s Corrected First Notice of Reliance.”

B. Opposer’s Objections to Third-Party Registrations Not Well Taken

See Evidentiary Appendix

C. Opposer Has Waived Objections to Applicant’s Cross Questions in Mr. Shimada’s Testimonial Deposition

See Evidentiary Appendix

VI. ARGUMENT

A. Opening Statement

Applicant contends that likelihood of confusion between Opposer’s Mark and Applicant’s Mark is not likely, largely because the shared portion of both marks, “CHEW,” is a generic or highly descriptive term for Opposer’s goods, “fruit chews.” The additional matter in both marks, “HI-” in Opposer’s Mark and “MY” in Applicant’s mark, are sufficiently disparate to warrant a finding by the Board that the marks in question are not confusingly similar.

B. DuPont Factors Weigh in Favor of Applicant

In determining likelihood of confusion, the TTAB focuses on whether consumers would mistakenly assume that the applicant’s goods emanate from the same source as, or are associated with, the goods in the cited registration. This determination is made on a case-specific basis, by analyzing all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). These factors include: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” v. careful, sophisticated purchasing; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and

the conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between the applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of use. *Id.*

1. DuPont Factor: Similarity of Marks

The first *DuPont* factor requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 476 F.2d at 1361. The Court of Appeals for the Federal Circuit has provided the following guidance with regard to determining and articulating likelihood of confusion:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted). **On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark,** provided the ultimate conclusion rests on consideration of the marks in their entireties (footnote omitted). Indeed, this type of analysis appears to be unavoidable. *Emphasis added.*
In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

Applicant believes that the meaning of the word “CHEW” in relation to the goods of the parties is central to the likelihood of confusion analysis in this case. Furthermore, Applicant believes that a thorough exploration of the “connotation” issue will establish clearly that “HI” is the dominant portion of Opposer’s mark, and that “MY” is the dominant portion of Applicant’s mark, strengthening Applicant’s position against likelihood of confusion. This exploration of “connotation” will inform and guide the manner in which the HI-CHEW (stylized) and MYCHEW (stylized) marks are viewed in the likelihood of confusion analysis. Ultimately, Applicant hopes to show through this process that Applicant’s Mark is unlikely to cause confusion with Opposer’s Mark.

Applicant will therefore devote much of its argument herein to the subject of “connotation.” In support of the contention that the meaning of “CHEW” will lead the , Applicant looks to the following sources of record: (i) The dictionary definitions of “CHEW”; (ii) certain responses to Applicant’s discovery requests; (iii) the use of the term “fruit chews” in a generic fashion by Opposer’s witness, Mr. Shimada, in his deposition; (iv) the use of the term “fruit chews” in Opposer’s pleaded trademark registrations and trademark applications of record, as well as labels of record; (v) third-party registrations containing the terms “CHEW” or “CHEWY,” and pluralizations thereof; (vi) the process in which Opposer selected its mark; and (vii) the incorrect transliteration of Opposer’s Mark.

(a) Connotation

(i) The “CHEW” Portion of the Parties’ Marks is Generic or Highly Descriptive - Dictionary Definitions of “CHEW”

Applicant notes that the definition of the word “CHEW,” as shown in Exhibit A of Opposer’s Corrected First Notice of Reliance, and reproduced above in the Description of the Record section, is: Definition 1: 1: to crush, grind, or gnaw (as food) with or as if with the teeth ... — **chewable** *adj.* ... **chewy** *adj.* Definition 2: 1: ... 2: something for chewing. Applicant respectfully requests that these definitions be judicially noticed. Fed. R. Evid. 201 (b); TBMP Section 704.12. Applicant asserts that Definition 1 of “chew” clearly describes how consumers eat Opposer’s product, in spite of Mr. Shimada’s evasive response to cross question No. 14 in his deposition,¹⁵ and in spite of the fact that the term “fruit chews” is used directly on Opposer’s product as a generic term to identify its goods.¹⁶ Accordingly, Applicant contends that the term “CHEW” has virtually no source-identifying capacity in the marks in question with respect to the goods of the parties.

¹⁵ Q: Is it true that the term CHEW describes how your consumers eat your HI-CHEW candy? A: It was not the Company’s intention to adopt such term as would describe how consumers are to eat its candy products. Shimada Dep. ¶ 15.

¹⁶ See Paragraphs VII.B.(1)(a)(iii) and (iv) of this paper, directly below, discussing usage of the term “fruit chews” by Mr. Shimada and placement of the term “fruit chews” on Opposer’s labels.

(ii) The “CHEW” Portion is Generic or Highly Descriptive - Certain Responses to Applicant’s Discovery Requests

In response to Interrogatory No. 3 of Applicant’s First Set of Interrogatories, in which Opposer is asked to identify and describe all goods or services in connection with which Opposer has used its trademarks in the United States ..., Opposer stated: “Opposer states that the goods upon which the trademarks ‘HI-CHEW’ (under Registration No. 2626396) and ‘HI-CHEW’ (under Application Nos. 78523920 and 78523925) are affixed in the United States consist of chewing candy, also referred to as **fruit chews**.” *Emphasis added.* App.’s Corr. First NOR Par. 3(a), and Ex. C2 (accidentally labeled as Exhibit D1). Moreover, in Opposer’s response to Interrogatory No. 5 of Applicant’s First Set of Interrogatories, the following was stated: “(Opposer) adopted ‘HI-CHEW’ in 1975 for its **fruit chews**.” *Emphasis added.* App.’s Corr. First NOR Par 3(a), and Ex. C2 (accidentally labeled as Exhibit D1). Also, in Opposer’s Supplemental Responses to Applicant’s First Set of Interrogatories, Opposer stated the following in response to Interrogatory No. 5:

HI-CHEW **fruit chews** come in a variety of fruit flavors, such as strawberry, apple and grape (mango and kiwi – sold in Hawaii). Strawberries are depicted in Registration No. 3097367 in order to make customers aware and easily draw the customer’s attention to the fact that those **fruit chews** are strawberry flavored. *Emphasis added.*
App.’s Corr. First NOR Par. 3(b), and Ex. F1.

Applicant believes that these generic uses of the term “fruit chews” clearly show that the wording “fruit chews” is used to describe the genus of Opposer’s goods. As Opposer’s HI-CHEW Fruit Chews are sold in packs, it stands to reason that one piece of Opposer’s candy would be referred to as a “fruit chew.” Applicant maintains that that the term “CHEW” is generic or highly descriptive of Opposer’s HI-CHEW product.

In response to Interrogatory No. 8 of Applicant’s First Set of Interrogatories, Opposer provided the following statement: “Opposer states that representative samples of HI-CHEW labels ... can be found in Opposer’s document production HC00003, HC000020-22, HC000041, HC000044, and others.” App.’s Corr. First NOR, Par. 3(b), and Ex. C2 (accidentally labeled as

Ex. D1); App.'s Corr. First NOR, Par 3(f), and Ex. E2. A review of document HC00020, submitted as part of Exhibit E2 (and referenced in Exhibit C2 (accidentally labeled as Exhibit D1), Opposer's Objections and Responses to Applicant's First Set of Interrogatories), a good example of the generic and/or highly descriptive nature of the term "CHEW." First, on all of the four labels set forth in the advertisement, the generic term "FRUIT CHEWS" appears in the upper right corner, informing consumers of the generic name for the goods. At the top of the page, the following is written: "Fruit Chews in Japan since 1975." Then, just under this statement on the left side of the page is the term "Fruit Chews." At the bottom of the page, the following is written: "Juicy and Chewy Ever!" As Opposer's HI-CHEW Fruit Chews are sold in packs, it stands to reason that one piece of Opposer's candy would be referred to as a "Fruit Chew." Applicant maintains that that the term "CHEW" is generic or highly descriptive of Opposer's HI-CHEW product. Accordingly, Applicant reiterates its contention that the term "CHEW" has virtually no source-identifying capacity in the marks in question with respect to the goods of the parties.

(iii) The "CHEW" Portion is Generic or Highly Descriptive – Usage of Term by Mr. Shimada in Deposition

The following are excerpts from Opposer's testimonial deposition of Mr. Tetsuo Shimada, set forth here to highlight the generic or highly descriptive nature of the term "CHEW" in relation to Opposer's goods.

Q: If so, what products does Morinaga offer in the United States?

A: With particular focus on 「HI-CHEW」 **fruit chews**, Morinaga offers various kinds of candy, chocolates and snacks, for sale in the United States
Emphasis added. Shimada Dep. Cross Question ¶ 15.

Q: What goods or services are offered in connection with the HI-CHEW Marks?

A: Morinaga offers **fruit chews** bearing the HI-CHEW Marks
Emphasis added. Shimada Dep. Cross Question ¶ 23.

Q: Are fruit chews a type of candy?

A: Yes.
Emphasis added. Shimada Dep. Cross Question ¶ 26.

Q: If so, what is the history of the development and adoption of the HI-CHEW Marks?

A: ... Having garnered such success, the Company decided to adopt 「HI-CHEW in Katakana characters」, 「HICHEW」, and 「HI-CHEW」 as brands for its fruit chews, which it began selling in 1975.

Emphasis added. Shimada Dep. Cross Question ¶ 28.

Q: If so, why?

A: In particular, both are fruit chews products”

Emphasis added. Shimada Dep. Cross Question ¶ 70.

Applicant maintains that that the term “CHEW” is generic or highly descriptive of Opposer’s HI-CHEW product. Accordingly, Applicant asserts, as above, that the term “CHEW” has virtually no source-identifying capacity in the marks in question with respect to the goods of the parties.

(iv) The “CHEW” Portion is Generic or Highly Descriptive – Usage of term “Fruit Chews” on Pleaded Registrations/Applications and Labels by Opposer

The generic wording “FRUIT CHEWS” is placed directly under Opposer’s Mark in the marks shown in the applications set forth in Par. 3 of the Notice of Opposition, Ser. Nos. 78523925 and 78523930 (now Reg. Nos. 3325869 and 3181707), as follows:



and



.¹⁷ Rights to the term “FRUIT CHEW” have been

disclaimed by Opposer in these registrations. Moreover, the label shown on page 1 of Opposer’s Trial Brief shows the term “Fruit Chews” prominently depicted on the upper rights side of Opposer’s “fruit chew” pack. Opposer has clearly acknowledged that it is only selling chewing candy known as “fruit chews” under all of its “HI-CHEW” marks in the United States.¹⁸ The

¹⁷ These marks are set forth and discussed in the Description of the Record section of this paper (Section I.A.(1)(3). The Board acknowledged that these mark are “pleaded marks” in its order of December 20, 2007, ruling on Applicant’s Motion to Compel (“Opposer’s pleaded marks include Registration Nos. 2626396, 3097367, 3181707 and 3325869”) (TTABVUE No. 29).

¹⁸ See Opposer’s Objections and Responses to Applicant’s First Set of Interrogatories, response to Interrogatory No. 3: “Opposer states that the goods upon which the trademarks ‘HI-CHEW’ (under Registration No. 2626396) and ‘HI-CHEW’ (under Application Nos. 78523920 and 78523925) are affixed

word “CHEW” in “FRUIT CHEWS” is modified by the word “FRUIT” (for example: What kind of “chew” is it? It is a “fruit chew.”). Clearly, the word “CHEWS” in “FRUIT CHEWS” is identical (except for the “s”) to the word “CHEW” in Opposer’s mark. Accordingly, Applicant repeats its assertion that the term “CHEW” has virtually no source-identifying capacity in the marks in question with respect to the goods of the parties.

(v) The “CHEW” Portion of the Parties’ Marks is Generic or Highly Descriptive – Third-Party Registrations

Applicant contends that the extensive existence of marks on the Principal Register containing the mark “CHEW” owned by third parties is helpful in highlighting the generic or highly descriptive nature of the word “CHEW” in connection with Opposer’s mark.¹⁹ Third-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1285 (Fed. Cir. 1984). *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976).

Applicant has made a strong case that the word “CHEW” is generic or highly descriptive of the parties’ goods by submission of numerous third-party registrations in Exhibit G2 to Applicant’s Corrected First Notice of Reliance. Applicant provides information about the contents of Exhibit G2 in the following:

- Applicant submitted **201** copies of *live* third-party registrations (printed out from the TESS database) of marks containing the letters “CHEW,” with a *current basis under Section 1(a)*, but without regard to international class.²⁰ App.’s Corr. First NOR at Par. 4, and Ex. G2.

in the United States consist of chewing candy, also referred to as fruit chews.” App.’s Corr. First NOR Par. 3(a), and Ex. C2 (accidentally labeled as Exhibit D1); *See also* Mr. Shimada’s testimonial deposition: Q: What goods or services are offered in connection with the HI-CHEW Marks? A: Morinaga offers **fruit chews** bearing the HI-CHEW Marks (Shimada Dep. Cross Question ¶ 23).

¹⁹ Applicant argues that its third-party registrations were admissible and of probative value in the “Evidentiary Corrections, Explanations, and Arguments” section of this paper above (Section VI.B).

²⁰ The third-party registrations that were submitted that comprise Ex. G2 are as follows (with numbers corresponding to the numbers set forth in the “Chart 1 – 319 Records” in App.’s Corr. First NOR at Par. 4): **[filed electronically (TTABVUE No. 51)]** 1, 2, 3, 4, 5, 6, 7, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 23, 24, **[filed electronically (TTABVUE No. 52)]** 27, 28, 29, 31, 32, 33, 34, 35, 36, 37, 38, 39, 41, 42, 43, 44, 45, 48, 49, 50, 52, 57, 58, 59, 60, 61, 62, 64, 65, 66, 67, 68, 69, 70, 71, 73, 74, 75, **[filed electronically**

- Of these 201 copies, **57** were for goods in Class 30.²¹ Specimens of use were submitted for an additional 4 *live* registrations containing the lettering “CHEW” and *currently based under Section 1(a)*, and these registrations were set forth in “Chart 1 – 319 Records of App.’s Corr. First NOR at Par. 4 (TESS copies were not submitted inadvertently).²²
- Of the 61 third-party registrations for marks in Class 30 mentioned above (57 TESS copies, plus 4 “orphan” specimens of use submitted without TESS copies), 17 specimens of use were submitted to show examples of generic or descriptive usage.²³
- Of the 61 third-party registrations for marks in Class 30 mentioned above (57 TESS copies, plus 4 “orphan” specimens of use submitted without TESS copies), 19 registrations contained the lettering “CHEWY” (or “CHEWIE” or “CHEWIES”),²⁴ and 42 contained the lettering “CHEW” (or “CHEWS” or “CHEWING”).²⁵

In Opposer’s Trial Brief, Opposer argued as follows: “The majority of the registrations identified by Applicant are not for candy or related products – most in fact are for pet products.” Opp.’s Trial Brief at 16. Opposer also noted in a foot note that “[s]everal of the registrations included in Applicant’s list are registrations owned by Opposer.” *Id.* at foot note no. 4. Applicant responds by contending that, even if many of the third-party registrations are not related to

(TTABVUE No. 53)] 76, 77, 79, 80, 81, 82, 83, 84, 86, 87, 90, 91, 92, 93, 94, 96, 99, [filed electronically (TTABVUE No. 56)] 101, 102, 103, 104, 105, 106, 108, 109, 114, 115, 116, 118, 119, 120, 121, 125, 126, 127, 128, 129, 130, 131, 132, 133, 134, 135, 137, 139, 140, 141, 142, 143, 144, 146, 147, 148, 150, 152, 156, 159, 160, 162, 163, 164, 165, 166, 168, 169, 170, 172, 173, 174, 175, 176, 177, 178, 179, 180, 181, 182, 183, 184, 188, 189, 190, 191, 193, 194, 195, 197, 198, 200, 201, 202, 204, 205, 207, 208, 210, 212, 213, 215, 216, 218, 219, 221, 224, 225, 226, 227, 230, 232, 233, 235, 236, 240, 241, 243, 244, 245, 246, 247, 248, 249, 250, 251, 252, 253, 254, 255, 256, 258, 260, 262, 263, 270, 271, 277, 278, 280, 281, 282, 284, 285, 287. App.’s Corr. First NOR at Par. 4, and Ex. G2.

²¹ The third-party registrations for goods in Class 30 that were submitted that comprise Ex. G2 are as follows (with numbers corresponding to the numbers set forth in “Chart 1 – 319 Records” in App.’s Corr. First NOR at Par. 4): 7, 11, 12, 27, 29, 34, 38, 39*, 42*, 52, 57, 58, 59, 60*, 62, 70, 80, 84, 86, 87*, 90, 102, 103, 104, 116, 129, 135, 137, 140, 152, 156, 162, 163, 165, 166, 174, 176, 178, 180, 193, 197, 221, 232, 235, 236, 241, 246, 248, 251, 252, 256, 265, 280, 284, 285, 286. App.’s Corr. First NOR at Par. 4, and Ex. G2.

²² Specimens of use for four registrations set forth in “Chart 1 – 319 Records” in App.’s Corr. First NOR at Par. 4 were submitted without corresponding TESS copies, namely, Nos. 141, 192, 231, and 261. App.’s Corr. First NOR at Par. 4, and Ex. G2.

²³ Specimens of use were submitted for the following registrations identified in “Chart 1 – 319 Records,” found in Par. 4 of App.’s Corr. First NOR: 12, 29, 103, 141 [No TESS], 174, 180, 192 [No TESS], 221, 231 [No TESS], 236, 241, 246, 252, 261 [No TESS], 280, 285, 286 (the underlined items were scanned into the TTABVUE system and designated as TTABVUE No. 57).

²⁴ “Chart 1 – 319 Records “ – Nos. 7, 11, 34, 38, 52, 62, 135, 137, 140, 152, 162, 163, 165, 166, 176, 197, 248, 251, 287. App.’s Corr. First NOR at Par. 4, and Ex. G2.

²⁵ “Chart 1 – 319 Records” – Nos. 12, 27, 29, 39, 42, 57, 58, 59, 60, 70, 80, 84, 86, 87, 90, 102, 103, 104, 116, 129, 141, 156, 174, 178, 180, 192, 193, 221, 231, 231, 235, 236, 241, 246, 252, 256, 261, 265, 280, 284, 285, 286. App.’s Corr. First NOR at Par. 4, and Ex. G2.

“candy,” this in no way negates the impact of those that are. Applicant respectfully requests that the third-party registrations for goods/services unrelated to candy be weighed for whatever probative value they might have. Of course, Applicant expect the Board to weigh more heavily those items related to candy. In this regard, Applicant provides an amended chart in the following, based on the “Chart 1 – 319 Records” in Par. 4 of App.’s Corr. First NOR,²⁶ focusing on those third-party registrations for goods that are related to candy on the basis of their common definitions. Applicant calls special attention to those marks in the below chart having the same construction as Opposer’s Mark, that is, a mark ending in “CHEW” or “CHEWS,” namely, Nos. 12, 29, 39, 42, 57 (ending in CHEWZ), 58, 59, 60, 84, 87, 90, 101, 110, 119, 120, 174, 192, 221, 236, 241, 246, 252, 261, 281, 285, and 286.

CHART 1 – 319 Records			
	Reg. Number	Word Mark	Goods/Services
7	3166541	GOOEY CHEWY	*Class 030: candy * excluding frozen confections and excluding ingredients for use in frozen confections *. FIRST USE IN COMMERCE: 20050329
11	3236591	GINGER CHEWIES	Class 030: line of food products, namely, cookies and cakes. FIRST USE IN COMMERCE: 20000600
12	3522614	SIP-N-CHEW <i>NOTE: Specimen attached hereto Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name “Exhibits for Defendant” in “History Text” column, and labeled in pen as “Ex. G2 – Specimen for No. 12 in Chart 1 of Notice of Reliance”</i>	*Class 030: Candy. FIRST USE IN COMMERCE: 20060609
27	3374276	DON'T CHEW LIKE A COW, CHEW LIKE A HUMAN !	*Class 030: confectionery, namely, chewing gum and candy. FIRST USE IN COMMERCE: 20071011
29	3201692	DREAM CHEWS <i>NOTE: Specimen attached hereto Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name “Exhibits for Defendant” in “History Text” column, and labeled</i>	*Class 030: Candy. FIRST USE IN COMMERCE: 20060109

²⁶ Applicant cautions the Board that the chart has merely been copied and pasted from Applicant’s Notice of Reliance, for the sake of consistency, such that errors mentioned above in Section VI.A of this paper (Evidentiary Corrections, Explanations, And Arguments) have been reproduced.

		<i>in pen as "Ex. G2 No. 29 in Chart I of Notice of Reliance"</i>	
34	3183163	HARD 'N FRUITY NOW/SOFT 'N CHEWY LATER	*Class 030: Candy. FIRST USE IN COMMERCE: 20020101
38	3106676	QUAKER CHEWY	Class 030: Grain-based snack bars consisting primarily of grain, and grain-based snack bars containing chocolate, nuts and/or dried fruit. FIRST USE IN COMMERCE: 19810710
39	3095524	GH BRANDS CALIFORNIA ALMOND CHEWS NOTE: Specimen attached hereto	*Class 030: Confectionery made in whole or part of California almonds, namely candy, candy bars, candy chews, chocolates, white chocolates, milk chocolates, dark chocolates, chocolate truffles, bonbons, turrón candy, divinity, taffy, nougat made with or without inclusions such as fruit or flavorings or berries or citrus peel or nuts or grains. FIRST USE IN COMMERCE: 20050606
42	3129138	FRENCH CHEW NOTE: Specimen attached hereto	*Class 030: Taffy and chewy nougat candy. FIRST USE IN COMMERCE: 18710101
46	3243624	AHLGRENS BILAR CHEWY CANDY CARS SWEDISH TRADITION SINCE 1953	*Class 030: candy. FIRST USE IN COMMERCE: 19960000 <i>Copy of TESS page not submitted</i>
50	3122000	CHEW SWISH AND SWIRL	Class 003: Mouth and breath fresheners and deodorizers. FIRST USE IN COMMERCE: 20060323
52	3349417	CHOCO-CHEWY	*Class 030: candy. FIRST USE IN COMMERCE: 20070709
57	2908842	WILD CHERRY CHEWZ NOTE: Specimen attached hereto	*Class 030: Candy. FIRST USE IN COMMERCE: 20020301
58	2913399	FRUIT CHEWZ NOTE: Specimen attached hereto	*Class 030: Candy. FIRST USE IN COMMERCE: 20020731
59	2751398	PEPPERMINT CHEWZ NOTE: Specimen attached hereto	*Class 030: Candy. FIRST USE IN COMMERCE: 20020301
60	2796067	CINNAMON CHEWZ NOTE: Specimen attached hereto	*Class 030: Candy. FIRST USE IN COMMERCE: 20020731
62	3665358	PECAN CHEWY	Class 030: Cookie bar made a with shortbread crust topped with a blend of honey, butter and nuts. FIRST USE IN COMMERCE: 19980100
70	2913908	WANT FLAVOR? CHEW ON!	*Class 030: CONFECTIONERY, NAMELY GUM. FIRST USE IN COMMERCE: 20031117
80	2995073	CHEWZERS	*Class 030: Candy. FIRST USE IN COMMERCE: 20041025
84	3319473	FUN CHEWS NOTE: Specimen attached hereto	*Class 030: Candy. FIRST USE IN COMMERCE: 20070511
86	2974575	CHEWING GUAM	*Class 030: Candy. FIRST USE IN COMMERCE: 20040601
87	2982205	CLUB CHEW NOTE: Specimen attached hereto	*Class 030: Chewing gum and candy. FIRST USE IN COMMERCE: 20050514
90	3069112	NUTRIMMUNE CHEWS NOTE: Specimen attached hereto	*Class 030: CARMEL CHEWS CONTAINING COLOSTRUM AND CALCIUM. FIRST USE IN COMMERCE: 20040215
101	3030073	GOODY2CHEWS	Class 029: Bite-sized fruit and nut based nutritional snack food. FIRST USE IN COMMERCE: 20051003

102	2872764	CHEW THE GUM...KEEP THE BOX!	*Class 030: chewing gum. FIRST USE IN COMMERCE: 20021218
103	2910338	BUTTER TOFFEE THE FAMILIAR CREAMY TASTE IN A CLASSIC TOFFEE CHEW NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Specimen for No. 103 in Chart 1"</i>	*Class 030: Toffee candy. FIRST USE IN COMMERCE: 20020604
104	2814181	CHEW MORE. DO MORE.	*Class 030: Confectionary products, namely chewing gum and nutritional candy bars. FIRST USE IN COMMERCE: 20021206
110	2846363	CRAN CHEWS	Class 029: Dried fruits, namely intermediate moisture, sugar infused dried cranberries. FIRST USE IN COMMERCE: 19990317 <i>Copy of TESS page not submitted</i>
116	3683860	CHEWPREMES	Class 030: Cookies. FIRST USE IN COMMERCE: 20080630
119	3648707	HOODOO CHEW	Class 029: Nut and seed-based snack bars; Protein based, nutrient-dense snack bars. FIRST USE IN COMMERCE: 20090325
120	3648706	HOODOO CHEW	Class 005: Nutritional energy bars for use as a meal substitute. FIRST USE IN COMMERCE: 20090325
123	3635241	CHEWY ATOMIC FIREBALL	*Class 030: Candy. FIRST USE IN COMMERCE: 20070930 <i>Copy of TESS page not submitted</i>
124	3635238	CHEWY LEMONHEAD & FRIENDS	*Class 030: Candy. FIRST USE IN COMMERCE: 20070930 <i>Copy of TESS page not submitted</i>
125	3632105	BRAIN-BOOSTING CHEWING GUM	Class 005: Breath-freshening chewing gum for medicinal purposes; Herbal chewing gum providing mental alertness. FIRST USE IN COMMERCE: 20071001
129	3603138	CHEWS YOUR ADVENTURE	*Class 030: Candy; Candy bars. FIRST USE IN COMMERCE: 20081001
130	3423787	CHEW-A-BULLS	Class 031: Dog and pet food treats. FIRST USE IN COMMERCE: 20080107
135	3575595	CHEWY LEMONHEAD	*Class 030: Candy. FIRST USE IN COMMERCE: 20070930
137	3572405	CHEWY CHOCOLATE CHEEKS	Class 030: Bakery products, namely, sweet bakery goods. FIRST USE IN COMMERCE: 20070401
140	3539748	OATMEAL CHEWIE	Class 030: oatmeal based snack bars. FIRST USE IN COMMERCE: 19980617
141	3540916	CHEWPHORIA NOTE: Specimen attached hereto	*Class 030: Bubble gum and Chewing gum. FIRST USE IN COMMERCE: 20080401 <i>Copy of TESS page not submitted</i> <i>Copy of specimen of use attached</i>

152	3471508	CHEWY MIX	*Class 030: candy. FIRST USE IN COMMERCE: 19950830
153	3473529	COFFEE RIO CHEWY	*Class 030: Candy. FIRST USE IN COMMERCE: 20080424 <i>Copy of TESS page not submitted</i>
154	3466839	CHEWBARKA'S TAGS	<i>Copy of TESS page not submitted</i>
155	3452231	CHAT, CHEW & CHOCOLATE FUN FOR FABULOUS WOMEN!	<i>Copy of TESS page not submitted</i>
156	3444657	THE ENERGY DRINK YOU CHEW	*Class 030: gums, namely, chewing gum, flavored chewing gum, chewing gum with additives for energy, caffeinated chewing gum, chewing gum with vitamins, chewing gum with minerals, energy chewing gum. FIRST USE IN COMMERCE: 20041231
162	3379773	CHOCOLATEY CHEWY POP	*Class 030: candy. FIRST USE IN COMMERCE: 20070701
163	3358188	SOUR CHEWY POP	*Class 030: Candy. FIRST USE IN COMMERCE: 20070701
165	3363924	CHEWY CANES	*Class 030: Candy. FIRST USE IN COMMERCE: 20070801
166	3363923	CHEWY POPS	*Class 030: Candy. FIRST USE IN COMMERCE: 20070701
174	3275719	MIGHTY CHEW NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Specimen for No. 174 in Chart 1"</i>	*Class 030: candy and chewing gum. FIRST USE IN COMMERCE: 20050901
176	2827194	ORIGINAL SNAPS BRAND CLASSIC CHEWY CANDY	*Class 030: Candy. FIRST USE IN COMMERCE: 20021015
177	2697314	CHEW FOR HEALTH	Class 005: Nutraceutical gum for use as a nutritional supplement. FIRST USE IN COMMERCE: 20011210
178	2535065	BREW OR CHEW	Class 030: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, breakfast cereals, bread, bakery goods, frozen confections, candy, honey, treacle, yeast, baking powder, salt, mustard, vinegar, spices, ice, and condiments, namely sauces. FIRST USE IN COMMERCE: 19980723
179	2723478	"TEXAS CHEWIE" PECAN PRALINES	Class 030: caramelized sugar candy with pecans. FIRST USE: 19491231. FIRST USE IN COMMERCE: 19491231
180	2705221	FRUIT CHEWLICIOUS NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Spec. for No. 180 in Chart 1"</i>	*Class 030: Confectionery, namely, candy. FIRST USE IN COMMERCE: 20000900
192	2547331	XYLICHEW NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in</i>	*Class 030: Chewing gum. FIRST USE IN COMMERCE: 19981210 <i>Copy of TESS page not submitted</i>

		<i>TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Specimen for No. 192 in Chart 1"</i>	
193	3305210	AFTER COFFEE CHEWING GUM	*Class 030: Candy, namely, a candy coated chewing gum. FIRST USE IN COMMERCE: 20000910
197	3182038	CHEWY CONE CAKES	Class 030: Bakery and dessert products - namely, cones filled with cake and icing. FIRST USE IN COMMERCE: 20040729
221	2749888	GINSENG CHEWS NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Specimen for No. 221 in Chart 1"</i>	*Class 030: ginseng/honey taffy candy. FIRST USE IN COMMERCE: 19970620
225	2826009	CHEWLET	Class 005: Medicated chewing gum containing nutritional supplements and pharmaceutical preparations, namely, analgesics, antihistamines and antacids, which are capable of administration in oral form, for administering such supplements and preparations. FIRST USE IN COMMERCE: 20030915
231	2705222	CHEWLICIOUS NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Spec. for No. 231 in Chart 1"</i>	*Class 030: Confectionery, namely, candy. FIRST USE IN COMMERCE: 20000900 <i>Copy of TESS page not submitted</i>
232	2707684	CHOCOLATE CHEWLICIOUS NOTE: Same specimen as No. 231	*Class 030: Confectionery, namely, candy. FIRST USE IN COMMERCE: 20000900
235	2531501	CHEW-CHOO CHOCOLATE BAR	*Class 030: full range of chocolates and chocolates molded items. FIRST USE IN COMMERCE: 19841119
236	2499792	GINGER CHEWS NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Spec. for No. 236 in Chart 1"</i>	*Class 030: confectionary, namely, ginger candy in a variety of flavors. FIRST USE IN COMMERCE: 19980817
237	2334021	GINGER CHEWIE	Class 030: line of food products, namely, cookies and cakes. FIRST USE IN COMMERCE: 19951221 <i>Copy of TESS page not submitted</i>
241	2582937	CALCICHEWS NOTE: Specimen attached hereto	*Class 030: calcium fortified pastries, bakery goods, chewy nougats, candy creams, candy bars, chocolate, yogurt and

		<i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Spec. for No. 241 in Chart 1"</i>	candy coated crackers and cookies. FIRST USE IN COMMERCE: 20001115
245	2332701	CHEWTRITION	Class 005: Nutritional supplements, namely, vitamins and mineral supplements; medicated chewing gum containing creatine for use as a nutritional and dietary supplement. FIRST USE IN COMMERCE: 19970613 (CANCELLED) *Class 030: [chewing gum]. FIRST USE IN COMMERCE: 19970613
246	2319581	KOOKY CHEW NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Spec. for No. 246 in Chart 1"</i>	*Class 030: candy. FIRST USE IN COMMERCE: 19970519
248	2297158	CRISPY NUT-N-CHEWY	*Class 030: chocolate candy. FIRST USE IN COMMERCE: 19900900
251	2230926	CHEWY BABY	*Class 030: candy. FIRST USE IN COMMERCE: 19980402
252	2229900	ZOO CHEWS NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Spec. for No. 252 in Chart 1"</i>	*Class 030: candy. FIRST USE IN COMMERCE: 19930900
256	2232754	CHEW SMART	*Class 030: bubble gum. FIRST USE IN COMMERCE: 19970606
259	2154355	CHEWY MIX	*Class 030: candy. FIRST USE IN COMMERCE: 19950830 <i>Copy of TESS page not submitted</i>
261	2435570	CHICLE CHEWS NOTE: Specimen attached hereto <i>Filed with documents referenced as submission No. 57 in the prosecution history for the case in TTABVUE, under the name "Exhibits for Defendant" in "History Text" column, and labeled in pen as "Ex. G2 – Spec. for No. 261 in Chart 1"</i>	*Class 030: chewing gum. FIRST USE IN COMMERCE: 19980300 <i>Copy of TESS page not submitted</i>
263	2290428	CHEW ONE FOR A BLAST, TWO FOR AN EXPLOSION, THREE ONLY IF YOU DARE!	Class 003: breath fresheners, namely, chewable breath drops. FIRST USE IN COMMERCE: 19970600
264	2357906	CHEWY LOUIE	Class 030: food products, namely, ice-cream. FIRST USE IN COMMERCE: 19990901

			<i>Copy of TESS page not submitted</i>
265	2129918	TOFFEE CREAM CHEESE CHEWS	Class 030: bakery goods, namely, cakes. FIRST USE IN COMMERCE: 19951002
279	1803348	RICH'N CHEWY	Class 030: cookies. FIRST USE IN COMMERCE: 19831026 <i>Copy of TESS page not submitted</i>
280	1934372	CHEW STIK NOTE: Specimen attached hereto	*Class 030: combination candy and chewing gum. FIRST USE IN COMMERCE: 19940600
281	1749779	CALCI-CHEW	Class 005: chewable calcium carbonate tablets for use as a dietary supplement. FIRST USE IN COMMERCE: 19860100
284	1566188	CANEL'S CHEWING GUM	*Class 030: foods, namely chewing gum. FIRST USE IN COMMERCE: 19850900
285	1265893	WHA GURU CHEW NOTE: Specimen attached hereto	*Class 030: Candy. FIRST USE IN COMMERCE: 19741025
286	1580311	PEANUT CHEWS NOTE: Specimen attached hereto	*Class 030: candy. FIRST USE IN COMMERCE: 19210000 <i>Copy of TESS page not submitted</i>
287	1120654	GIANT CHEWY SWEETARTS	*Class 030: candy. FIRST USE IN COMMERCE: 19780410
316	0742731	SUNNY CHEWS NOTE: Specimen attached hereto	*Class 030: Candy. FIRST USE IN COMMERCE: 19620108 <i>Copy of TESS page not submitted</i>

Applicant submits that the significant existence of *live* third-party registrations, based on *actual use*, containing the lettering “CHEW” and related to candy strengthens Applicant’s assertion that the “CHEW” portion of the marks in question is generic or highly descriptive.²⁷

The extensive lists of registered marks containing the term “CHEW” demonstrate that Opposer’s analysis in its Trial Brief is contrary to the extensive case law requiring that diluted terms be afforded a narrow scope of protection.²⁸ Put another way, marks consisting of a

²⁷ Applicant notes with dismay that Mr. Shimada, who, at the time of his deposition in April of 2009, was the General Manager of the Business Development Division and Head of the General Affairs Center (Shimada Dep. Direct Question ¶ 1), and who, at the time that Opposer’s Supplemental Responses to Applicant’s First Set of Interrogatories was prepared in October 2007, was Manager of Intellectual Property Department of Opposer (Opp.’s Supp. Resps. To App.’s First Set of Interrogs., App.’s Corr. First NOR Par. 3(e), and Ex. F1, Supp. Resp. to Interrog. No. 27), refused to acknowledge that he was aware of any trademarks containing the word “CHEW” (Q: “Are you aware of any other company that produces candy or gum that uses a mark containing the lettering “CHEW,” either as a separate word or as part of a larger term, as a brand name?” A: “No, I am not.” Shimada Dep. Cross Question ¶ 16 (at page 31)). This statement seems truly unbelievable.

²⁸ *E.g., Textronix, Inc. v. Daktronics, Inc.*, 187 U.S.P.Q. 588 (TTAB 1975), *aff’d*, 189 U.S.P.Q. 693, 695 (CCPA 1976) (“the mere presence of a common, highly suggestive portion [here, TRONIX or TRONIX] is usually insufficient to support a likelihood of confusion”) (emphasis added); *In re The Lucky Co.*, 209

commonly used word are considered “weak” and entitled to decidedly narrow protection. *General Mills Inc. v. Kellogg Co.*, 3 U.S.P.Q. 2d 1442 (8th Cir. 1987) (OATMEAL RAISIN CRISP for breakfast cereal not confusingly similar to APPLE RAISIN CRISP, also for breakfast cereal). In such cases, “consumer confusion has been found unlikely because the marks’ components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related.” *Id.* at 1445 (citations omitted). In the *General Mills* case, the goods were identical and directly competitive; yet the weakness of the plaintiff’s mark means that “small variations between marks [are] likely to make enough of a difference to defeat [an] infringement claim.” *Id.*, citing *Beech-Nuts, Inc. v. Warner-Lambert Co.*, 346 F. Supp. 547, (S.D.N.Y. 1972), aff’d, 480 F. 2d 801 (2d Cir. 1973).

(vi) The “CHEW” Portion of the Parties’ Marks is Generic or Highly Descriptive – Selection of Opposer’s Mark

Applicant believes that the selection process of Opposer’s mark sheds light on the generic or highly descriptive nature of the “CHEW” portion of its mark. Throughout the discovery and testimony periods, Opposer refused to admit that the word “CHEW” in its mark has any meaning, in spite of overwhelming evidence otherwise. In effect, Opposer refuses to dissect its mark. Opposer has refused to acknowledge that it is aware of any other trademarks for candy containing the lettering “CHEW.” For example, the following exchanges occurred in Mr. Shimada’s deposition:

U.S.P.Q. 422, 423 (TTAB 1980) (the average purchaser of athletic shoes has been so conditioned by the large number of strip and stripe designs that they notice even slight differences in the marks); *Keebler Co. v. Associated Biscuits Ltd.*, 207 U.S.P.Q. 1034, 1039 (TTAB 1980) (JACOB’S CLUB (with JACOB’S in small lettering) not confusingly similar to CLUB, for chocolate biscuits and crackers, respectively, based upon numerous third-party registrations of marks incorporating the term CLUB for relative goods). *Accord: Sun Banks of Florida, Inc. v. Sun Federal Savings and Loan Association*, 651 F. 2d 311 (5th Cir. 1981) (extensive third party use of the term SUN was the basis for finding no likelihood of confusion between SUN BANK and SUN FEDERAL SAVINGS); *Amstar Corp. v. Domino’s Pizza*, 615 F. 2d 252 (5th Cir. 1980), *cert. denied*, 449 U.S. 889 (1980) (numerous third party uses and registrations for DOMINO resulted in no likelihood of confusion); *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F. 2d 496, 505 (5th Cir. 1979) (multiple uses of WORLD); *American Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F. 2d 3 (5th Cir. 1974) (multiple uses of HERITAGE).

Q: Is it true that the term CHEW describes how your consumers eat your “HI-CHEW” candy?

A: It was not the Company’s intention to adopt such a term as would describe how consumers are to eat its candy products.

Shimada Dep. Cross Question ¶ 14 (at p. 30).²⁹

Q: Is it true that the term CHEW is descriptive of your company’s chewable candies?

A: I do not think so.

Shimada Dep. Cross Question ¶ 15 (at pp. 30-31).

Q: In your opinion, what does the word “MY” contained in Defendant’s MYCHEW mark mean?

A: In my opinion it does not convey any meaning.

Shimada Dep. Cross Question ¶ 70 (at p. 44).

Q: In your opinion, what does the word “HI” contained in your company’s “HI-CHEW” mark mean?

A: In my opinion it does not convey any meaning.

Shimada Dep. Cross Question ¶ 71 (at p. 44).

Q: In your opinion, are the words “HI” and “MY” similar in meaning.

A: I do not think that “MY” in “MYCHEW” and “HI” in “HI-CHEW” convey any meaning.

And, Applicant responded as follows to an interrogatory about meaning:

Interrogatory No. 23: Describe the meaning that Opposer is conveying or intending to convey to its customers by using the term “HI-CHEW” as a trademark, if any.

First Response: [Objections omitted] Opposer cannot possibly respond as to the meaning that each customer gives to the term HI-CHEW.³⁰

First Supplemental Response: [Objections omitted] Opposer’s use of the HI-CHEW mark is intending to convey a consistent brand identity in its use of the HI-CHEW trademark, given the success of the candy products under the “**HI**” family of marks over the course of the past 30 years.³¹ *Emphasis added.*

Second Supplemental Response: HI-CHEW does not have any particular meaning in either Japanese or English, thus Opposer is not necessarily conveying or intending to convey anything specific to the customer by using the HI-CHEW mark. Rather, HI-CHEW is part of a **family of marks** dating back to 1964. In 1964, Opposer adopted and began selling chocolates under the brand name “Hi-CROWN.” Hi-CROWN was a huge success in Japan. In 1969, Opposer developed milk caramels which were sold under the

²⁹ Applicant believes this was an evasive answer, as Applicant’s cross question called for a “yes”/“no”-type response.

³⁰ Opposer’s Objections and Responses to Applicant’s First Set of Interrogatories (*Redacted*), App.’s Corr. First NOR Par. 3(a), and Ex. C2 (accidentally labeled as Exhibit D1).

³¹ Supplemental Responses to Applicant’s First Set of Interrogatories (Oct. 30, 2007), App.’s Corr. First NOR Par. 3(b), and Ex. F1.

brand name “Hi-Soft.” Given the good will Opposer had already acquired in using these brand names, Opposer adopted “HI-CHEW in 1975 for fruit chews.³² *Emphasis added.*

From Applicant’s vantage point, Opposer’s reluctance to admit that the components of its mark have any meaning whatsoever looks suspect. Mr. Shimada could have taken the approach of admitting that the components of the marks have at least some meaning while arguing nonetheless that the marks in question are confusingly similar. Instead, Mr. Shimada chose to refute any indication that “MY,” “HI,” and “CHEW” could have meaning to consumers. This directly contradicts the content of Opposer’s response to Applicant’s First Set of Interrogatories, Interrogatory No. 5: “Since each of the components of “HI-CHEW” is not a Japanese word, it is spelled entirely in Katakana.”³³ This statement seems to admit that Opposer’s Mark, when written in Japanese, is taken from “HI” and “CHEW,” two components from the English language.

The fact that Opposer created its “HI-CHEW” mark based on a successful “family of marks” supports the notion that the “CHEW” portion of Opposer’s Mark is not the portion that identifies source. Rather, it is the “HI” portion of the mark that plays a much more important in that role. The following is the story of the how Opposer selected its mark, as told in Opposer’s Response to Interrogatory No. 5:

Interrogatory No. 5: Describe the circumstances, methods and reasoning surrounding Opposer’s selection of its trademarks”

First Response: [Objections omitted] Opposer stated that Opposer adopted and began selling chocolates under the brand name “Hi-CROWN,” which were very successful in Japan. In 1969, Opposer introduced milk caramels under the brand name “HI-SOFT.” Because of the goodwill that Opposer had already acquired in both brand names, it adopted “HI-CHEW” in 1975 for its fruit chews. HI-CHEW is the English transliteration for ハイチュウ.³⁴ The Japanese language is phonetic and written in three forms: Kanji,

³² Opposer’s Supplemental Responses to Applicant’s First Set of Interrogatories (Jan. 22, 2008), App.’s Corr. First NOR Par. 3(c). This response was a result of the Board’s order of December 20, 2007 granting in part Applicant’s Motion to Compel.

³³ Opposer’s Objections and Responses to Applicant’s First Set of Interrogatories (*Redacted*), App.’s Corr. First NOR Par. 3(a), and Ex. C2 (accidentally labeled as Exhibit D1).

³⁴ Actually, Applicant does not believe that “HI-CHEW” is the correct transliteration of ハイチュウ, as argued in a subsequent section. Applicant believes that the correct transliteration is “HAI-CHUU” or “HAI-CHŪ.”

which is adopted from Chinese characters, Hiragana characters and Katakana characters. Hiragana is used to write Japanese words, while Katakana is used to write foreign words, or words that originate from foreign languages which have been adopted in practice by different sectors of Japanese society. Since each of the components of “HI-CHEW” is not a Japanese word, it is spelled entirely in Katakana. Thus, ハ is for the “ha” sound, イ is a vowel pronounced as “ee,” and together produce the sound “hi,” while チュ is for “chyu” and ヲ is a vowel pronounced as the “oo” in “look,” and together produce the sound “chew.”³⁵

First Supplemental Response: [Objections omitted] Opposer began selling chocolate candy products under the HI-CROWN mark in the late 1960’s, and then introduced chocolate caramel products under the HI-SOFT mark in 1969. Noting that it had met considerable success with these brand name products containing the word “HI,” Opposer decided to continue to build the brand name and in 1977 Opposer began selling its soft candy products under the HI-CHEW mark. Opposer began selling its HI-CHEW soft candy in strawberry and apple flavor and introduced the orange flavor to the market in 1979 and the peach flavor in 1990. Opposer thereafter began selling other flavors such as grape, lemon, apricot and plum.³⁶

Applicant has taken the time to present Opposer’s responses to Interrogatory No. 5 because the responses clearly show that “HI” is the source identifying component of Opposer’s Mark. It is clear that Opposer built up goodwill in its “HI” family of marks, and simply affixed a generic or highly descriptive term to its source-identifying “HI” mark. Just as Opposer had attached “SOFT,” a very descriptive term for “soft candy,” to its “HI” mark, creating “HI-SOFT” in 1969, so did Opposer attach “CHEW,” a descriptive term for “fruit chews,” to its “HI” mark, creating “HI-CHEW” in 1975 (or 1977). Opposer indicated the following in its Trial Brief: “The use of “HI” and “MY” are both arbitrary in connection with the parties’ respective goods, would convey no meaning, and would do little to prevent confusion between these two marks.” Opp.’s Trial Brief at p. 8. This works well with Applicant’s theory. Yes, it is the “HI” and “MY” portions of the respect marks that are distinctive and identify source; it is the “CHEW” portion that is generic or highly descriptive. The fact that Opposer actually has a family of “HI” marks serves to support this contention.

³⁵ Opposer’s Objections and Responses to Applicant’s First Set of Interrogatories (*Redacted*), App.’s Corr. First NOR Par. 3(a), and Ex. C2 (accidentally labeled as Exhibit D1).

³⁶ Supplemental Responses to Applicant’s First Set of Interrogatories (Oct. 30, 2007), App.’s Corr. First NOR Par. 3(b), and Ex. F1.

(vii) The “CHEW” Portion of the Parties’ Marks is Generic or Highly Descriptive –Incorrect Transliteration of Opposer’s Mark

Applicant submits that the correct transliteration of “HI-CHEW in Katakana characters” (ハイチュウ) is “HAI-CHUU” or “HAI-CHŪ.” A variation of this is “HAI-CYU.” By no means is the correct transliteration “HI-CHEW.” Specifically, the “oo” sound in Japanese cannot properly be transliterated into English as “EW.” Applicant believes that this fact undergirds the notion that “CHEW” has meaning in relation to Opposer’s “fruit chews,” calling into doubt Mr. Shimada’s contention “[i]t was not the Company’s intention to adopt such a term as would describe how consumers are to eat its candy products.” Shimada Dep. Cross Question ¶ 14 (at p. 30).

Opposer allegedly first used its “HICHEW in Katakana characters” in the United States in 1994; later, in 2001, Opposer allegedly began using its “HI-CHEW” (stylized) mark, which is the mark upon which Opposer has relied.³⁷ For seven years, Opposer used a mark in commerce in Japanese letters that sounded exactly like Opposer’s Mark. It would be reasonable assume that, if Opposer’s Mark had no meaning, as Opposer claims, Opposer would have introduced a direct transliteration of its mark in Roman letters. Instead, Opposer chose to use the term “CHEW,” a transliteration that does not exist in standard transliteration systems of Japanese to English. Specifically, the “oo” sound in Japanese cannot competently be transliterated into English by using the letters “EW.” Accordingly, it follows that Opposer’s Mark is a translation from Japanese conveying meaning, not a transliteration. This position is supported by the translation and transliteration statement that is of record with respect to Opposer’s pleaded U.S. Reg. No. 3097367: “The non-Latin characters in the mark, the large characters in the center of the mark are translated as “HI-CHEW” and their transliteration is “HAI-CYU.” Although the attached Japanese-English dictionaries would indicate that the second syllable of Opposer’s mark in Japanese would be transliterated as “CHUU” or “CHŪ,” Opposer certainly agrees that in no

³⁷ Shimada Dep. Direct Question ¶ 32.

circumstances can Opposer's mark in Japanese be properly transliterated as "CHEW." Rather, "CHEW" conveys meaning.

An important sign that the "CHEW" portion of Opposer's Mark conveys meaning is the fact that the Japanese mark is written in *katakana*, not *hiragana*. The following is written in the Webster's New World Compact Japanese Dictionary regarding *hiragana* and *katakana*:

The following chart shows the two Japanese phonetic writing systems (syllabaries): the cursive symbols to the left are *hiragana*; the angular symbols to the right are *katakana*. *Hiragana* is used for prefixes and suffixes to the Chinese characters (*kanji*) and for purely Japanese words; ***katakana* is used for words of foreign origin and on official documents.** *Emphasis added.*³⁸

Opposer's Mark in Japanese is written in *katakana* as ハイチュウ ("hai-chuu"). The fact that the letters are in *katakana* means that the Japanese was adopted from a foreign word. The Opposer itself echoed these sentiments in its response to Interrogatory No. 5, as follows:

The Japanese language is phonetic and written in three forms: Kanji, which is adopted from Chinese characters, Hiragana characters and Katakana characters. Hiragana is used to write Japanese words, while Katakana is used to write foreign words, or words that originate from foreign languages which have been adopted in practice by different sectors of Japanese society. **Since each of the components of "HI-CHEW" is not a Japanese word**, it is spelled entirely in Katakana. Thus, ハ is for the "ha" sound, イ is a vowel pronounced as "ee," and together produce the sound "hi," while チュ is for "chyu" and ウ is a vowel pronounced as the "oo" in "look," and together produce the sound "chew."³⁹ *Emphasis added.*

Opposer gives the impression in its response that "chew" is the correct transliteration of チュウ ("chew"), but this is not the case. Importantly, though, as stated in the previous section of this Brief, Opposer admits that *katakana* is used for Opposer's Mark because "each of the components of "HI-CHEW" is not a Japanese word." This implies that one of the components of Opposer's Mark is "HI," and it is an English word, and one of the components of Opposer's Mark is "CHEW," and it is an English word. Thus, the meaning of "CHEW" is an unmistakable element of Opposer's Mark.

³⁸ App.'s Corr. First NOR Par. 2(c), and Exhibit B3, under the "Romaji (Romanization)" heading.

³⁹ Opposer's Objections and Responses to Applicant's First Set of Interrogatories (*Redacted*), App.'s Corr. First NOR Par. 3(a), and Ex. C2 (accidentally labeled as Exhibit D1).

As evidence of the proposition that the チュウ (“chū” or “chuu”) portion of Opposer’s Mark cannot be transliterated as “CHEW,” Applicant turns to the explanations in the four Japanese-English dictionaries for support.

[1] Exhibit B1: Pocket Kenkyusha Japanese Dictionary (Oxford University Press 2003)⁴⁰

The following is written in this dictionary in Paragraph 1 of the page that is entitled “Guide to the Use of the Dictionary”:

The romanization used in this dictionary is based on the standard Hepburn system with the following modifications: 1.1 Long vowels are indicated by double voweled letters, ‘aa, ii, uu, ee, oo,’ instead of the conventional transcription, which, depending on the particular vowel, either used macrons or doubles the vowel letter.

One of the examples given is: “shuuchuu しゅうちゅう (concentration)” (pronunciation accent marker 「」 omitted). The Japanese version of the second syllable of “shuuchuu,” is exactly the same sound as the second syllable of the Japanese version of Opposer’s mark, which is comprised of three letters and written as チュウ (“chuu”) in *katakana* (the equivalent of ちゅう (“chuu”) in *hiragana*). The syllable, having a long vowel at the end, is romanized (transliterated) as “chuu,” not “chew.”

Moreover, on the two pages that are entitled “A Table of Japanese Sounds,” the first column (farthest to the left) lists the five romanized vowels of Japanese: a, i, u, e, o. The column to the right of the first column sets forth two Japanese letters, one in *hiragana* and one in *katakana*, for each vowel. The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chuu”), in *katakana*, the last letter being ウ (“u”). According to the table, the ウ (“u”) in Opposer’s mark should be romanized (transliterated) as “u,” not “ew.”

⁴⁰ App.’s Corr. First NOR Par. 2(a), and Exhibit B1

In the second row from the bottom of the full table, the romanized letter combinations ending in the sound “yu” are set forth, starting with kyu, gyu, shu, ju, chu, ju, and nyu. The columns to the right of these romanized letter combinations set forth two sets of Japanese letter combinations, one in hiragana and one in katakana, corresponding with each respective romanized letter combination. The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chuu”), in katakana, the first two letters being チュ (“chu”). According to the table, the チュ (“chu”) in Opposer’s mark should be romanized (transliterated) as “chu,” not “chew.” The full sound チュウ (“chuu”), comprised of three letters and having a long vowel at the end, would be romanized (transliterated) as “chuu,” according to this dictionary, not “chew,” as seen in the example given above in the section entitled “Guide to the Use of the Dictionary” relating to the word “shuuchuu.”

On pages 42 and 43 of the dictionary, entries of Japanese words are presented that start with the Japanese letter combination ちゅう (“chū”) in hiragana, identical in sound to the Japanese letter combination チュウ (“chū”) in katakana, which are the same three letters comprising the second syllable of Opposer’s mark. All of the romanized (transliterated) entries start with “chuu,” not “chew.”⁴¹

[2] Exhibit B2: Basic Japanese-English Dictionary , Second Edition (Oxford University Press and Bonjinsha 2004)⁴²

In this dictionary, there is a table entitled: “Romaji • Hiragana • Katakana Comparative Table (ローマ字 • ひらがな • カタカナ対照表).” In this dictionary, long vowels such as “uu” are indicated by the use of a macron above the vowel (ū), which is noted in “Romanization notes” No. 5 under the table. In the second row of the table, the romanized versions of the five Japanese

⁴¹ By way of example, the first ten entries listed are as follows (with pronunciation accent markers such as 「 omitted): chuuburu (article), chuucho (hesitation), chuudan (discontinuance), chuudoku (poisoning), chuugaeri (somersault), chuugakkoo (junior high school), chuugaku (shortened form of junior high school), chuugakusee (junior high school pupil), chuugata (middle size), chuugen (mid-year gift).

⁴² App.’s Corr. First NOR Par. 2(b), and Exhibit B2

vowel sounds can be found, namely: a, i, u, e, o. Each romanized vowel is followed, in the column on its right, by the hiragana letter that is associated with the vowel sound, and then, in the column to the right of that, by the katakana letter that is associated with the vowel sound. In the columns to the immediate right of the letter “u,” to which a superimposed red arrow is pointing, are the letters う (“u” in hiragana) and ウ (“u” in katakana). The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chū”), in katakana, the last letter being ウ (“u”). According to the table, the ウ (“u”) in Opposer’s mark should be romanized (transliterated) as “u,” not “ew.”

In the fifth row of the table (stretching across two pages), the romanized versions of the letters and/or letter combinations starting with the letters “t” or “c” can be found, namely: ta, chi, tsu, te, to, cha, chu, cho. Each romanized letter or letter combination is followed, in the column on its right, by the hiragana letter or letter combination that is associated with the sound created, and then, in the column to the right of that, by the katakana letter or letter combination that is associated with the sound created. The letter combination “chu” in the said row (the fifth row) is in the sixth column from the right. The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chū”) in katakana, the first two letters being チュ (“chu”). According to the table, the チュ (“chu”) in Opposer’s mark should be romanized (transliterated) as “chu,” not “chew.” The full sound チュウ (“chū”), comprised of three letters and having a long vowel at the end, would be romanized (transliterated) as “chū,” according to this dictionary, not “chew.”

On pages 530 and 531 of the dictionary, entries of Japanese words are presented that start with the Japanese letter combination ちゅう (“chū”) in hiragana, identical in sound to the Japanese letter combination チュウ (“chū”) in katakana, which are the same three letters

comprising the second syllable of Opposer’s mark. All of the romanized (transliterated) entries start with “chū,” not “chew.”⁴³

**[3] Exhibit B3: Webster’s New World Compact
Japanese Dictionary, Rev. Ed. (Wiley Pub., Inc., 1997)⁴⁴**

In the “Guide to Pronunciation of Japanese” in this dictionary, an explanation of the sound of “Short Vowels” and “Long Vowels” is provided. Under the “Short Vowels” heading, it is indicated that the sound represented by the letter “u” is the same as the “u” sound in “true” and “cruel.” Under the “Long Vowels” heading, the following explanation is given: “The long vowels in this dictionary are indicated by macrons; they are pronounced as the short vowels, but the sound is doubled in length” So, under this explanation, the second syllable of the Japanese version of Opposer’s mark, which is チュウ (“chū”), would be written as “chū.”

A section called “Romaji (Romanization)” explains how Japanese letters are romanized, that is, transliterated into English. The following helpful information is stated in this section: There are three systems for writing Japanese in the Latin alphabet: 1) *Hepburn (Hebon-shiki)*, most generally used, 2) *Official (Kunrei-shiki)*, now almost obsolete, and 3) *Japanese (Nihon-shiki)*. Basically, the three systems are alike; the Hepburn system is used throughout this dictionary as it is considered the easiest to use insofar as pronunciation is concerned.

The table of the Japanese alphabet (syllabary) is printed on two pages in this dictionary. On the first page, the five vowels of the Japanese language can be found in the first row of the table as they are romanized (transliterated) into English, and those vowels are: a, i, u, e, o. Underneath the third vowel in the row, which is “u,” are the two Japanese letters representing the sound “u,” namely, う (“u” in hiragana) and ウ (“u” in katakana). The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chū”) in

⁴³ The left side of each page contains the Japanese entries and definitions, and the right side on each page contains the romanized versions of the each entries and the definitions in English. The romanized version of the entries on these pages are as follows: chūi (attention), chūō (center), chūgakusei (junior high school student), chūgakkō (junior high school), chūsha (injection).

⁴⁴ App.’s Corr. First NOR Par. 2(c), and Exhibit B3

katakana, the last letter being ウ (“u”). According to the table, the ウ (“u”) in Opposer’s mark should be romanized (transliterated) as “u,” not “ew.”

On the next and final page of the table, the seventh row of romanized letters from the top consists of four romanized letter combinations starting with the letter “c,” namely: cha, chu, che, cho. Underneath the second letter combination in the row, which is “chu,” are the two Japanese letter combinations representing the sound “chu,” namely, ちゅ (“chu” in hiragana) and チュ (“chu” in katakana). The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chū”) in katakana, the first two letters being チュ (“chu”). According to the table, the チュ (“chu”) in Opposer’s mark should be romanized (transliterated) as “chu,” not “chew.” The full sound チュウ (“chū”), comprised of three letters and having a long vowel at the end, would be romanized (transliterated) as “chū,” according to this dictionary, not “chew.”

On page 315 of the dictionary, entries of Japanese words are presented that start with the Japanese letter combination ちゅう (“chū”) in hiragana, identical in sound to the Japanese letter combination チュウ (“chū”) in katakana, which are the same three letters comprising the second syllable of Opposer’s mark. All of the romanized (transliterated) entries start with “chū,” not “chew.”⁴⁵

**[4] Exhibit B4: Random House Japanese-English
English-Japanese Dictionary (Random House
Publishing Group and Ballantine Books 1995)⁴⁶**

On page x of this dictionary, there are sections on Romanization and Pronunciation. The following is written: ROMANIZATION OF JAPANESE: The system of romanization used in this dictionary is a modified form of the widely used Hepburn system. The only significant

⁴⁵ The romanized entries starting with chū on this page are: chū (middle), chūcho (hesitation), chūdoku (poisoning), chūgen (mid-year present), chūgakkō (junior high school), Chūgoku (China), chūi (attention), chūjien (tympanitis), chūjitsu (faithfulness), chūkan ni (in the middle of), chūkoku (advice).

⁴⁶ App.’s Corr. First NOR Par. 2(d), and Exhibit B4

modification is the use of an apostrophe to indicate a break between certain double letters.

PRONUNCIATION Vowels: Japanese has five basic vowels, usually referred to as short vowels, which are romanized as a, i, u, e, and o. These are pronounced approximately like the “a” in “father,” the “ee” in “feet,” the “oo” in “mood,” the “e” in “met,” and the “o” in “fort,” respectively. They are pronounced in a relatively short, clipped manner in contrast to the so-called long vowels, which are produced by drawing out sounds of the short vowels to approximately twice their normal length. In the Hepburn system, the long vowels corresponding to a, u, and o are written by placing a macron over those letters, producing ā, ū, and ō.

In this dictionary, there is a table entitled “Table of Japanese Syllables in Rōmaji, Hiragana, and Katakana.” In the second row of the table on page *xix* (the first row being the row in which “RHK” is repeated), the romanized versions of the five Japanese vowel sounds can be found, namely: a, i, u, e, o. Each romanized vowel is followed, in the column on its right, by the hiragana letter that is associated with the vowel sound, and then, in the column to the right of that, by the katakana letter that is associated with the vowel sound. In the columns to the immediate right of the letter “u” are the letters う (“u” in hiragana) and ウ (“u” in katakana). The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chū”) in katakana, the last letter being ウ (“u”). According to the table, the ウ (“u”) in Opposer’s mark should be romanized (transliterated) as “u,” not “ew.”

In the fifth row from the bottom, the romanized versions of the letters and/or letter combinations starting with the letter “c” can be found, namely: cha, chi, chu, (che), and cho. Each romanized letter or letter combination is followed, in the column on its right, by the hiragana letter or letter combination that is associated with the sound created, and then, in the column to the right of that, by the katakana letter or letter combination that is associated with the sound created. The second syllable of the Japanese version of Opposer’s mark is comprised of three letters and written as チュウ (“chū”) in katakana, the first two letters being チュ (“chu”).

According to the table, the チュ (“chu”) in Opposer’s mark should be romanized (transliterated) as “chu,” not “chew.” The full sound チュウ (“chū”), comprised of three letters and having a long vowel at the end, would be romanized (transliterated) as “chū,” according to this dictionary, not “chew.”

On page 37 of the dictionary, entries of Japanese words are presented that start with the Japanese letter combination ちゅう (“chū”) in hiragana, identical in sound to the Japanese letter combination チュウ (“chū”) in katakana, which are the same three letters comprising the second syllable of Opposer’s mark. All of the romanized (transliterated) entries start with “chū,” not “chew.”⁴⁷ Applicant notes that the word “*chūin-gamu*” is listed in Japanese (in *katakana*) as “chewing gum.”

Applicant believes that this discussion on transliteration of the Japanese language is important in showing that “CHEW” has meaning. Opposer created its mark in Japanese by borrowing two English words, “HI” and “CHEW,” to create “ハイチュウ” (hai-chū). When Opposer put this term back into English for sale in the United States (seven years after commencing sales of its product under “ハイチュウ” (hai-chū)), Opposer naturally returned these words to their English spellings. Opposer adopted HI-CHEW to combine its distinctive “HI” family of marks with a generic or highly descriptive term which could describe Opposer’s fruit chews. Applicant believes that it is important to try to understand the thinking of the one representative of Opposer who has spoken directly in this case, Mr. Shimada, a native-Japanese person. In stating in his deposition that Opposer’s Mark has no meaning,⁴⁸ Mr. Shimada failed to appreciate that Opposer’s Mark is comprised of English words, written in *katakana* (for foreign

⁴⁷ Entries: chūgurai (medium-size), chūhen (novelette), chūi (attention), chūi (lieutenant), chūbukai (attentive), chūihō (weather warning), chūi jinbutsu (person of questionable background), **chūin-gamu (chewing gum)**, chūi suru (pay attention to), chūjien (middle-ear infection).

⁴⁸ Shimada Dep. ¶ 75 (Q: In your opinion, are the marks “HI-CHEW” and “MYCHEW” similar in meaning? A: “As I have replied in question nos. 70 and 71, I do not think that “MY” in “MYCHEW” and “HI” in “HI-CHEW” convey any meaning.)

words), and its second syllable cannot be transliterated as “CHEW.” Mr. Shimada’s statements about the meaning of Opposer’s Mark do not appear to be credible.

In light of the foregoing, Applicant requests that the Board take judicial notice of the fact that Opposer’s Mark in Japanese (in *katakana*) cannot correctly be transliterated as “HI-CHEW,” as the “oo” sound cannot correctly be represented by the letters “EW.”

(b) Dominance of Marks

In the present case, it is unbelievable that Opposer wishes to afford more weight to the shared portion of the marks, that is, the word “CHEW.” Opposer states the following in its brief in this regard:

The words HI-CHEW and MYCHEW have no meaning in the English language. Both are fanciful marks. However, the dominant portion of the marks, CHEW, would have the identical meaning for both marks, particularly since the marks are used on identical goods. The use of “HI” and “MY” are both arbitrary in connection with the parties’ respective goods, would convey no meaning, and would do little to prevent confusion between these two marks. [Opp.’s Brief, p. 8].

Applicant takes strong exception to Opposer’s analysis, which appears to ignore established trademark law. First, a “dominant” portion of a mark is considered to be, contrary to Opposer’s statement, the arbitrary portion, rather than the generic or descriptive portion. *See* TMEP Section 1207.01(b)(viii). Second, a “dominant” portion of a mark is never considered to be, contrary to Opposer’s statement, the most generic or descriptive portion thereof. *Id.* Applicant maintains that the dominant portion of Opposer’s mark is “HI,” not “CHEW”; likewise, Applicant submits that the dominant portion of Applicant’s mark is “MY,” not “CHEW.” The TMEP speaks to the question of dominance in compound word marks⁴⁹ in Section 1207.01(b)(viii), as follows:

⁴⁹ Applicant notes that, even though there is not a space between the “MY” portion and the “CHEW” portion of its mark, and even though there is a hyphen instead of a space in between the “HI” portion and the “CHEW” portion of Opposer’s Mark, the marks may be treated as being comprised of compound words. *See ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007) (analyzing a compound word mark without a space by treating the separate portions as distinct portions, stating: Contrary to applicant’s position that the term “Quest” is descriptive for opposer’s products, we find that the “Quest” portion of opposer’s mark is most likely suggestive of its goods and services, i.e., inasmuch as these goods and services are

When assessing the likelihood of confusion between compound word marks, one must determine whether a portion of the word mark is dominant in terms of creating the commercial impression. **Although there is no mechanical test to select a “dominant” element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark.** Accordingly, if two marks for related goods or services share the same dominant feature and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely. *See In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987) (JM ORIGINALS (with “ORIGINALS” disclaimed) for various items of apparel held likely to be confused with JM COLLECTABLES for “knitwear – namely, sport shirts”).

If the common element of two marks is “weak” in that it is generic, descriptive, or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER’S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno, Toscano “SCLAVO” S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with “ASO” disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids). *Emphasis added.*
TMEP Section 1207.01(b)(viii).

Applicant asserts that the common portion of the two marks in question is weak in that it is generic or highly descriptive of the goods of both parties. Applicant believes that it has fully explored the generic or highly descriptive nature of “CHEW” in relation to “fruit chews.” A discussion of “HI” and “MY” follows.

“HI” is arbitrary with respect to Opposer’s goods. The dictionary definition of “HI” that is of record indicates that “HI” means: “*interj* – used esp. as a greeting.” This has nothing to do with “fruit chews,” or candy in general. “HI” is certainly the dominant portion of Opposer’s Mark.

“MY” is arbitrary with respect to Applicant’s goods. The dictionary definition of “MY” that is of record indicates that “MY” means: “:of or relating to me or myself esp. as possessor

used for research, the word “Quest” has a suggestive meaning in terms of hunting for answers.). *Id.* (page 27 on TTABVUE version of case).

agent, object of an action, or familiar person.” This portion of Applicant’s Mark is the dominant portion thereof.

Applicant asks the Board to find that the two marks in question do not share dominant portions, and that the shared portion is an extremely weak component of both marks, in relation to the relevant goods.

(c) Appearance

Opposer has argued as follows with respect to the similarity of the marks:

Both marks use the identical number of letters – six. The core of both marks employs the identical word “CHEW.” The only visual difference between the marks is that Opposer’s mark begins with “HI” and Applicant’s mark begins with “MY.” Visually, the letters “H” and “M” are very similar, as are the letters “I” and “Y.” Replacing the letters “HI” with “MY” does little to alter the appearance of the overall mark, which remains dominated by the term “CHEW.”

Applicant presents the following counterarguments to Opposer’s reasoning. Applicant agrees that the marks both have six letters, but notes that four of these letters represent the generic or highly descriptive term “CHEW.” With regard to “fruit chews” and packs of gum, consumers surely have become accustomed to looking beyond the word “CHEW” when assessing the source of the product. *In re The Lucky Co.*, 209 U.S.P.Q. 422, 423 (TTAB 1980) (the average purchaser of athletic shoes has been so conditioned by the large number of strip and stripe designs that they notice even slight differences in the marks). Applicant does not agree that the “only” visual difference between the marks is that one begins with “HI” and the other “MY.” Applicant reminds Opposer that both marks are noticeably stylized. It is well known that consumers often put more emphasis on the beginning of a mark than on the end.⁵⁰

In addition, Applicant does not agree with Opposer that the letters “M” and “H” are very similar. Applicant contends that the letter “H” and the letter “I” have similar angles (right angles), while the letter “M” and the letter “Y” have similar angles (45 degree angles). In the alternative,

⁵⁰ See *Chantelle v. De Millus Comercio e Industria De Roupas S.A.*, Opposition No. 91094834 Jan. 14, 2004)(finding the mark “DANTELE” not to be confusingly similar with the mark “CHANTELLE,” and commenting: “In particular, the marks begin with different letters, and these differences, because they are at the beginning of the marks, are more likely to be noted by the consuming public.”).

Applicant would argue that the analysis of the “M” and the “H” should not be isolated from the letters that follow. If a consumer were to accidentally think the “M” in “MYCHEW” was an “H,” this would not automatically lead to the consumer mistaking Applicant’s mark for Opposer’s mark. Rather, the “Y” after the imaginary “H” would cause the consumer to take another look, as the letter “Y” does not commonly follow the letter “H.” A consumer knowledgeable of the HI-CHEW brand would probably notice if he or she mistook the “M” for an “H,” and then saw a “Y,” as the mark “HY-CHEW” would be strange to the consumer.

Applicant strongly disagrees with Opposer’s contention that “replacing the letters “HI” with “MY” does little to alter the appearance of the overall mark, which remains dominated by the term “CHEW.” Applicant has gone to great lengths to show that, in fact, the word “CHEW” is generic or highly descriptive, and therefore cannot “dominate” either of the parties’ marks.

Applicant would also like to point out the following differences in the respective appearances of the marks:

- Applicant’s “C” is more closed than Opposer’s “C,” in “CHEW”;
- Applicant’s “W” does not have points, whereas Opposer’s “W” is quite pointy;
- Applicant’s Mark has a distinctive rising angle, with each letter positioned higher than the next;
- Opposer’s Mark has a shadow effect, whereas Applicant’s Mark does not⁵¹
- Opposer’s Mark has a hyphen, whereas Applicant’s Mark does not.

Regarding the hyphen, Opposer has cited two cases in support of the contention that a hyphen does not distinguish two otherwise similar marks. In the *Sunrider Corp. v. Shoban Lal Jain* case (comparing OLINA and OI-LIN), a hyphen separating a generic term from a distinctive one was not at issue, as here. In *In re Dr. Mitchell Swartz* (comparing SUN-BUG and SUN & BUG STUFF), a both marks had matter separating terms, unlike this case. Both cases were not citable as precedent. Applicant requests that the Board find that the marks are different in appearance.

(d) Sound

⁵¹ Applicant notes that the label of Applicant’s Mark presented at the beginning of Opposer’s Brief (on page 1) is not a label used in the United States, and Applicant’s applied-for mark is not the same.

Opposer argues that the marks rhyme. Applicant responds that this is only one factor to be considered, and Applicant asserts that the generic or highly descriptive nature of the term “CHEW” outweighs the sound factor in this case. Moreover, the TTAB has found in the past that rhyming marks for similar goods are not similar (*See Chantelle v. De Millus Comercio e Industria De Roupas S.A.*, Opposition No. 91094834 Jan. 14, 2004)(finding the mark “DANTELE” not to be confusingly similar with the mark “CHANTELLE,” and commenting: “In particular, the marks begin with different letters, and these differences, because they are at the beginning of the marks, are more likely to be noted by the consuming public.”). Furthermore, the cases that are most cited to with respect to sound are ones in which the mark of the party taking advantage of the sound factor is found to be “famous.”⁵² Applicant asserts that Opposer’s Mark is not famous.

(e) Commercial Impression

Applicant asserts that the commercial impressions of the respective marks are not confusingly similar, in view of the generic or highly descriptive nature of the term “CHEW,” the differing connotations of the words “HI” and “MY,” the stylizations of the respective marks, and commonality and descriptiveness of the term “CHEW” as used in third-party registrations. Applicant requests that the Board rule in favor of Applicant regarding the factor of “similarity of the marks.”

(2) Similarity of the Goods

TMEP Section 1207.01(a)(i) offers the following regarding potentially related goods: “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.” *See*,

⁵² *See G.D. Searle & Co. v. Chas. Pfizer & Co.*, 265 F.2d 385, 387, 121 USPQ 74, 76 (7th Cir. 1959), *cert. denied*, 361 U.S. 819 (1959) and *Crown Radio Corp. v. Soundsciber Corp.*, 184 USPQ 221, 223 (CCPA 1974) and *Hoffman-La Roche Inc. v. Knoll Pharm. Co.*, 167 USPQ 183, 185 (TTAB 1970) and *Interlego AG V. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002) and *American Cyanamid Co. v. U.S. Rubber Co.*, 356 F.2d 1008, 148 USPQ 729 (CCPA 1966) (all these cases awarding the sound factor to a party in light of the fame of that party’s mark).

e.g., Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field). Opposer’s evidence is insufficient to show that the goods will be marketed in the same way. In the alternative, Applicant submits that the dissimilarity of the mark Applicant respectfully contends that the differences in the marks outweighs the possibility that the goods may be related.

Applicant comments that, although Applicant’s goods may be purchased by consumers on impulse, it stands to reason that purchasers become conditioned to identifying source by looking outside of a generic or highly descriptive term, such as “CHEW” for “fruit chews.”

(3) Fame

Opposer argued in its Trial Brief that its HI-CHEW mark is famous. Applicant respectfully disagrees. As support for its claim of fame, Opposer looks to the testimony of Mr. Shimada in Par. 39 of his deposition, and the ruling of a Japanese court, as set forth on page 25 on Exhibit I of Opposer’s Notice of Reliance. Applicant believes that the Opposer has not provided sufficient evidence to establish fame of its mark, nor has it made the necessary effort.

In Par. 39 of Mr. Shimada’s deposition, the following is stated, in response to the question “[a]pproximately how many products with the HI-CHEW Marks have been sold in the U.S.?:

REDACTED

Opposer has not provided a dollar value for its sales in arguing that its mark should be afforded the protections of a “famous” mark. Opposer has simply set forth numbers of “packs.”⁵³

Moreover, Opposer’s advertising expenditures have [REDACTED]. In Par. 37 of Mr. Shimada’s deposition, the following is stated, in response to the question “[a]pproximately how much money has been spent on advertising and marketing the goods with the HI-CHEW Marks on a yearly basis since they have begun advertising in the U.S.?: “The Company spent.”

REDACTED

[Shimada Dep.

Direct Question ¶ 37]. Applicant notes that this advertising was for all HI-CHEW Marks, as defined in Paragraph 3 of the Instructions and Definitions of Mr. Shimada’s deposition, which states:

The term “Opposer’s Marks or “HI-CHEW Marks” means the “HI-CHEW” marks owned and registered by Morinaga & Co., Ltd. as embodied in with [sic] the United States Patent and Trademark Office and Registration No. 2,626,396 and Registration No. 3,097,367 and Registration No. 3,181,707 and Registration No. 3,325,869. [Shimada Dep. at p. 2].

Opposer did not rely on all of the marks pleaded or mentioned in its Notice of Opposition in its Brief. Rather, Opposer only relied on Reg. No. 2,626,296. Accordingly, the impact of the advertising expenditures testified to by Mr. Shimada in his deposition is lessened by the fact that the expenditures have not been broken down by trademark. Therefore, it is impossible to tell, for example, if any of the [REDACTED] spent on advertising in 2005 was dedicated to the only mark relied upon by Opposer in its Notice of Reliance, namely, the mark shown in Reg. No. 2,626,396. In view of this, Applicant maintains that the amount of advertising spent by Opposer on its products sold under its HI-CHEW mark supports Applicant’s assertion that Opposer’s mark is not “famous.”

⁵³ Applicant notes that Mr. Shimada did provide yen amounts with respect to sales, rather than dollar amounts, in Paragraph 40 of Mr. Shimada’s deposition. Paragraph 40, however, was not relied upon by Opposer in its Notice of Reliance, and the yen amounts were not converted to dollars. No exhibits are identified in Paragraphs 39 or 40 or Opposer’s Brief to support dollar figures. Even if Opposer were to have identified exhibits containing dollar amounts for Opposer’s sales, Applicant would have argued that the amounts [REDACTED] by the Board that Opposer’s Mark is “famous.”

In *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit (CAFC) provided helpful comments about determining whether a mark should be afforded the status of “famous” in the likelihood of confusion analysis, as follows:

Direct evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion. Instead, our cases teach that the fame of a mark may be measured indirectly, among other things, by the **volume of sales** and **advertising expenditures** of the goods traveling under the mark, and by the **length of time** those indicia of commercial awareness have been evident. *See, e.g., Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 1072, 12 USPQ2d 1901, 1902 (Fed.Cir.1989) (NINA RICCI for perfume, clothing and accessories: \$200 million in sales, over \$37 million in advertising over 27 years); *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 1146-47, 227 USPQ 541, 542 (Fed.Cir.1985) (HUGGIES for diapers: over \$300 million in sales over 9 years, \$15 million in advertising in one year); *Specialty Brands Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 674-75, 223 USPQ 1281, 1284 (Fed.Cir.1984) (SPICE ISLANDS for teas, spices and seasonings: \$25 million annually in sales for spices, \$12 million between 1959 and 1981 for tea, "several million" in advertising, in use for 40 years); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1567-68, 218 USPQ 390, 392-93 (Fed.Cir.1983) (GIANT FOOD for supermarket services and food products: sales over \$1 billion in one year, "considerable amounts of money" in advertising, 45 years use); *DuPont*, 476 F.2d at 1361, 177 USPQ at 567; *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 50 C.C.P.A. 1120, 305 F.2d 916, 917-18, 134 USPQ 504, 506 (CCPA 1962) (MR. PEANUT DESIGN for nuts and nut products: \$350 million in sales, \$10 million in advertising over 10 years). **As the foregoing precedent illustrates, we have consistently accepted statistics of sales and advertising as indicia of fame: when the numbers are large, we have tended to accept them without any further supporting proof. Emphasis added.**

In *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 1371, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002).

In light of these helpful comments from the CAFC, Applicant sets forth the following comparative analysis in order to place the Opposer’s efforts to prove fame of its HI-CHEW (stylized) mark in context:

Case	Sales Volume	Advertising	Years of Use
<i>Bose Corp. v. QSC Audio Products Inc.</i> , 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002)	\$50 million per year	\$5 million per year	17 years
<i>Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.</i> , 889 F.2d 1070, 1072, 12 USPQ2d 1901, 1902	\$200 million over 5 years	\$37 million over 5 years	27 years

(Fed.Cir.1989)			
<i>Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.</i> , 774 F.2d 1144, 1146-47, 227 USPQ 541, 542 (Fed.Cir.1985)	\$300 million over 9 years	\$15 million in advertising in one year	9 years
<i>Specialty Brands Inc. v. Coffee Bean Distribs., Inc.</i> , 748 F.2d 669, 674-75, 223 USPQ 1281, 1284 (Fed.Cir.1984)	\$25 million in one year (for spices)	“Several million”	40 years
<i>Giant Food, Inc. v. Nation's Foodservice, Inc.</i> , 710 F.2d 1565, 1567-68, 218 USPQ 390, 392-93 (Fed.Cir.1983)	\$1 billion in one year	“considerable amounts”	45 years of use
<i>Planters Nut & Chocolate Co. v. Crown Nut Co.</i> , 50 C.C.P.A. 1120, 305 F.2d 916, 917-18, 134 USPQ 504, 506 (CCPA 1962)	\$350 million in sales over 10 years	\$10 million in advertising over 10 years	10 years
Opposer’s purported sales, advertising, and years of use under the HI-CHEW (stylized) mark only			

Opposer’s attention to the question of fame appears to be lacking in comparison to other companies that have proven fame of their marks before the TTAB, as Opposer has failed to provide a dollar amount for its sales, and has failed to provide any credible proof of advertising.

The TTAB has made it clear that a party has to earn the right to have its mark considered as “famous” in the likelihood of confusion analysis by submission of a significant amount of evidence. The following is stated in TMEP Section 1207.01(d)(ix) in this regard:

In view of the wide latitude of legal protection afforded to a famous mark, and the dominant role fame plays in the likelihood of confusion analysis, **a party who asserts that its mark is famous must clearly establish that its mark is viewed by relevant purchasers as a famous mark.** *Blue Man Productions, Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005) (Board rejected opposer’s argument that its mark was famous, noting that there was no evidence regarding the nature and extent of opposer’s promotion of its mark, no figures as to volume of sales or advertising expenditures, and no evidence showing recognition of the name by relevant purchasers as a famous mark; while the evidence showed that the opposer’s mark had appeared in printed publications, on the Internet, and in recorded broadcasts and as a result had achieved a degree of recognition as a

strong and distinctive mark for entertainment services, the evidence was insufficient to show that consumers had been so exposed to the mark that it would be considered a famous mark). *Emphasis added.*
TMEP Section 1207.01(d)(ix).

In support of its position that Opposer has not proved the “fame” of Opposer’s Mark, Applicant submits that Opposer’s efforts and evidence have been much lower in caliber than the efforts and evidence presented by the opposer in *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004). In this case, the CAFC found that evidence of more than \$5 million annual sales of products bearing the mark, over 100 years of use, and advertising expenditure of hundreds of thousands of dollars per year was insufficient to establish that RITZ had achieved the extensive public recognition of a famous mark. *Id.*; TMEP Section 1207.01(d)(ix).

Opposer has also argued that a decision of the Japanese Trademark Office in Invalidation No. 2006-89113 held that Opposer’s Mark is “widely recognized and known among consumers.” Applicant respectfully contends that such evidence of renown in Japan is wholly irrelevant to the question of whether a mark is “famous” in the United States under U.S. trademark law. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) and *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (foreign use of mark creates no rights in mark in U.S.); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 662 (TTAB 1983) (claim of fame in France and existence of pending U.S. application based on foreign registration insufficient to establish that fame extended to U.S.)

Based on the foregoing, Applicant respectfully requests that the Board rule that Opposer has failed to show that its mark is famous, and that the fame factor be weighed in favor of Applicant.

(4) The Number and Nature of Similar Marks In Use On Similar Goods

Applicant’s extensive submission of third-party registrations was discussed in the section above on connotation. *See* Section VI.B.1(a)(v) above.

VII. CONCLUSION

Applicant contends that the shared portion of Opposer's Mark and Applicant's mark, namely, CHEW, is generic or highly descriptive, based on dictionary definitions, third-party registrations, and other evidence, as discussed in the foregoing, such that the dominant portions of the marks are "HI," in the case of the Opposer, and "MY," in the case of the Applicant. Because the shared portion is so weak, and because "HI" and "MY" have distinctive connotations, to the extent that Opposer has built up goodwill in a "family of marks" with respect to the term "HI," Applicant respectfully requests that the subject opposition be dismissed. Applicant further requests that its MYCHEW (stylized) mark be allowed to advance to the Notice of Allowance stage of prosecution.

Respectfully submitted,

CROWN CONFECTIONARY CO., LTD.

Date: February 25, 2010

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **Applicant's Main Brief** has been served on Jess M. Collen, Esquire and Michelle C. Morris, Esquire, by mailing said copy on February 26, 2010, via United States Postal Service First Class Mail, postage prepaid, in consideration of the fact that the Postal Service was not open at the time of timely submission of the document, to:

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EVIDENTIARY APPENDIX

V. EVIDENTIARY CORRECTIONS, EXPLANATIONS, AND ARGUMENTS

A. Evidentiary Corrections

In preparing its Brief, Applicant discovered that there were some errors in Applicant's Corrected First Notice of Reliance, and would like to disclose those errors to the Board, in order to avoid confusion.

Applicant respectfully informs Opposer and the Board that Opposer's Objections and Responses to Applicant's First Set of Interrogatories (Redacted) is referred to in Applicant's Corrected First Notice of Reliance at Par. 3(a) as Exhibit C2, but was accidentally labeled as Exhibit D1. Thus, two documents are identified as Exhibit D1 (the other document is Applicant's First Request for Admissions, referenced at Par. 3(d) of App. Corr. First NOR. Opposer did not raise this issue in a Motion to Strike or its Trial Brief. Applicant respectfully requests that Applicant's First Set of Interrogatories (Redacted) be allowed to remain as part of Applicant's Corrected First Notice of Reliance in support of Applicant's case.⁵⁴

Applicant respectfully informs Opposer and the Board that Applicant's First Request for Production of Documents and Things, referenced at Par. 3(f) of App.'s Corr. First NOR at Par. as Exhibit E1 was not labeled. Opposer did not raise this issue in a Motion to Strike or its Trial Brief. Applicant expresses regret regarding this oversight.

Applicant respectfully informs the Opposer and the Board that Opposer's Responses to Applicant's First Request for Production of Documents and Things, referenced at Par. 3(f) of App.'s Corr. First NOR, was not submitted. However, Applicant did submit Document Nos. HC000020, HC000021, HC000022, HC000031, HC000065, HC000066, HC000077, HC000078, HC000105, HC000106, and HC000107 as Exhibit E2. Opposer did not raise this issue in a Motion to Strike or its Trial Brief. Applicant respectfully requests that these documents produced

⁵⁴ If permitted, Applicant would be happy to file a correctly labeled document with the Board to cure the mistake.

by Opposer be allowed to remain as part of Applicant's Corrected First Notice of Reliance in support of Applicant's case.⁵⁵

Applicant respectfully informs Opposer and the Board about the following errors in Applicant's Corrected First Notice of Reliance relating to the chart entitled "Chart 1 – 319 Records" in Par. 4:

- With regard to Mark Nos. 39, 42, 57, 58, 59, 60, and 87 in the chart, the Notice of Reliance indicates that a specimen of use for each of these marks was submitted as part of Exhibit G2. This is incorrect. Although TESS copies were submitted for these marks, specimens of use were not.
- With regard to Mark Nos. 141, 192, 231, 261, and 286 in the chart, the Notice of Reliance indicates that a TESS copy was filed for these marks as part of Exhibit G2. This is incorrect, as TESS copies were omitted. However, the most recent specimens of use for these marks were filed.

With regard to Applicant's numbered Par. 1 of Applicant's Notice of Reliance, the following is stated: "The dictionary definitions provided are indicated by a circle positioned next to the entry" App.'s Corr. First NOR at page 3. In fact, Applicant failed to properly place identifying blue circles next to the definitions. Applicant expresses regret regarding this omission. Applicant did, however, state the following in the same section: ". . . Applicant intends to rely on definitions for the following words: (a) 'chew' (and 'chew'-formative terms, such as 'chewable' and 'chewy'); (b) 'hi'; (c) 'high'; (d) 'my.'" *Id.* These definitions are listed in alphabetical order in the Exhibit 1 to Applicant's Corrected First Notice of Reliance, and easily identifiable. Applicant respectfully requests that the Board accept these definitions as properly submitted.

B. Opposer's Objections to Third-Party Registrations Not Well Taken

Applicant disagrees with Opposer's contention that the evidence presented by the Applicant has not been properly introduced, has not been authenticated, and is of no probative value.

1. Third-Party Registrations Properly Introduced and Authenticated

⁵⁵ Applicant would be happy to file a copy of Opposer's Responses to Applicant's First Request for Production of Documents and Things to supplement the record, if necessary.

Applicant maintains that the third-party registrations comprising Exhibit G2 have been properly introduced and authenticated. Opposer argues as follows: “[T]his Board has consistently rejected the submission of lists of trademark applications and registrations that are printed from the Trademark Office’s TESS database.” Opposer’s Brief (hereinafter, “Opp.’s Brief”) at p. 14. Opposer does not differentiate between the three lists presented in Par. 4 of Applicant’s Corrected First Notice of Reliance, namely, Exhibit G1, G2, and G3. Applicant has submitted over 200 copies of registration pages from the TESS database in connection with the list presented as Exhibit G2. Therefore, the argument that Opposer makes with respect to “lists,” and the case law set forth in support thereof, is inapposite with respect to Exhibit G2.⁵⁶

Opposer’s argues that registration pages from the TESS database should not be accepted by the Board, as such copies do not fall under the guidelines set forth in TBMP Section 1208.02.⁵⁷ Applicant notes that Chapter 1200 of the TBMP is for ex parte appeals. The more appropriate section governing third-party registration submissions is TBMP Section 704.03(b)(1)(B), which states:

It is not necessary that the copy of the third-party registration submitted with a notice of reliance (or with testimony or a stipulation) be certified, nor need it be a current status and title copy prepared by the Office; a plain copy (or legible photocopy) of the registration itself, or the electronic equivalent thereof, that is, a printout of the registration from the electronic records of the Office’s automated search system is all that is required.

This language is not entirely clear as to whether copies of registration pages from the TESS database are acceptable. Applicant argues, however, that the language “or the electronic equivalent thereof, that is, a printout of the registration from the electronic records of the Office’s automated search system” would include registration pages from the TESS database.

⁵⁶ Exhibit G2 was submitted in 5 parts: *The following does not include the marks for which TESS copies were not submitted:* TTABVUE No. 51 covers Marks 1 through 25 of 319; TTABVUE No. 52 covers Marks 26 through 75 of 319; TTABVUE No. 53 covers Marks 76 through 99 of 319; TTABVUE No. 56 covers Marks 100 through 287; TTABVUE No. 57 includes specimens of use for marks in the chart.

⁵⁷ “To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted.” TBMP Section 1208.02.

In practice, Applicant notes that the TTAB often accepts copies of registration pages from the TESS database, rather than certificates of registrations themselves, for the purpose of making third-party registrations of record.⁵⁸ Moreover, Trademark Manual of Examining Procedure (TMEP) Section 710.03 provides the following guidance:

To make registrations of record, soft copies of the registrations or the complete electronic equivalent (i.e., complete printouts taken from any of the USPTO's automated systems (X-Search, **TESS**, TARR, or TRAM)) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992). *Emphasis added.*

The rules clearly show that copies of registration pages from the TESS database are acceptable for making third-party registrations of record. The documents filed in connection with Exhibit G2 are amenable to submission under a Notice of Reliance. Accordingly the third-party registrations should not be excluded.

Opposer has challenged the probative value of the third-party registrations comprising Exhibit G2 with the following reasoning: "Further, even if third-party registrations and applications could be introduced merely through printouts from the TESS database (which they cannot), they would have no probative value for the purpose cited by Applicant." Opp.'s Brief at page 15. Opposer has based the premise of its argument on the following statement of general relevance provided by Applicant in Par. 4 of Applicant's Corrected First Notice of Reliance:

⁵⁸ See *Time Warner Entertainment Company, L.P. v. Fleet Wholesale Supply Co., Inc.*, Opposition No. 91155422, at page 7 (TTAB July 10, 2008)(ruling that the applicant's third-party registrations would be considered for whatever probative value they have, when copies of TESS database registration pages, not certificate of registrations, were submitted under applicant's notice of reliance); *The Black & Decker Corporation v. Emerson Electric Co.*, Opposition No. 91158891, at page 30 (TTAB March 23, 2007)(discussing third-party registrations when copies of TESS database registration pages, not certificate of registrations, were submitted under applicant's notice of reliance); *OMS Investments, Inc. v. Central Garden & Pet Company*, Opposition No. 91156249, at page 26 (TTAB July 10, 2006)(discussing third-party registrations when copies of TESS database registration pages, not certificate of registrations, were submitted under applicant's notice of reliance); *Schlage Lock Company v. Mark J. Staiano*, Opposition No. 91152703, at pages 6-7 (TTAB December 12, 2005)(stating: "Therefore, the TESS printouts in exhibit nos. 1-19 and the dictionary definitions in exhibit nos. 20-12 were properly submitted under notice of reliance.")

“Applicant believes the following Exhibits are relevant to show, *inter alia*, the extensive trademark use of the word “CHEW,” and “CHEW”-formative terms (such as “chewy” and “chewable”) in commerce in the United States.” App.’s Corr. First NOR at page 5. Opposer concludes: “The Board consistently prohibits the submission of third-party applications and registrations for **this cited purpose**.” Opp.’s Brief at page 15. *Emphasis added*.

Applicant disagrees with Opposer’s contention. Opposer has completely ignored the phrase “*inter alia*,” in Applicant’s statement of general relevance, which means “*among other things*.” Accordingly, there is no restriction in Applicant’s statement as to how Applicant might rely upon the third-party registrations under scrutiny here. If Opposer had read Applicant’s statement of general relevance correctly, it could have potentially objected to the indefinite nature of the statement. Opposer, however, did not argue that Applicant’s statement was overbroad.

Applicant acknowledges here that the phrase “*inter alia*” in its statement creates some ambiguity as to the relevance of the third-party registrations. TBMP Section 704.03(b)(1)(B) states the following with respect to the required statement of general relevance:

A party that wishes to make such a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration together with a notice of reliance thereon specifying the registration **and indicating generally its relevance**. *Id.* *Emphasis added*.

Whereas it may stand to reason that a party objecting to a statement in a notice of reliance based on that statement’s irrelevance may properly be raised in that party’s main trial brief, it does not follow that an objection to the overbroad or ambiguous nature of the statement of general relevance should be raised in the said brief. Rather, such an objection should be made promptly, according to TBMP Section 707.02(b), which states: “Ordinarily, a procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike if the defect is one that can be cured. *See Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (objection that notice of reliance did not set forth relevance of appended

documents raised for first time in brief waived). *Id.* Furthermore, TBMP Section 707.02(b)(2)

illustrates this point as follows:

An adverse party may object to a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted, as, for example, that a 37 CFR § 2.122(e) notice of reliance on a printed publication does not include a copy of the printed publication, **or does not indicate the general relevance thereof**, or that the proffered materials are not appropriate for introduction by notice of reliance. *Id. Emphasis added.*

Based on the foregoing, Applicant contends that Opposer has waived its objection to Applicant's statement of general relevance by failing to file a motion to strike. Applicant respectfully requests that the Board overrule Applicant's assertion that Applicant's third-party registrations are not entitled to any probative value be denied, based on Applicant's disregard for the phrase "*inter alia*," coupled with Applicant's failure to file a motion to strike based on the potentially overbroad nature of Applicant's statement.

Applicant would like to clarify its statement of general relevance here, substituting the opening paragraph of Par. 4 of Applicant's Corrected First Notice of Reliance with the following: Applicant believes the following Exhibits are relevant to show, *inter alia*, the extensive trademark use of the word "CHEW," and "CHEW"-formative terms (such as "chewy" and "chewable") in commerce in the United States, **and relevant to show generic or highly descriptive nature of the term "CHEW," and "CHEW"-formative terms, in connection with Opposer's goods.** TMEP Section 1207.01 (b)(iii) states the following in relation to using third-party registrations:

Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1285 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*,

534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). *Id.*

In light of the foregoing, Applicant respectfully requests that the Board permit the third-party registrations that are of record to be considered for any probative value they may have.

C. Opposer Has Waived Objections to Applicant's Cross Questions in Mr. Shimada's Testimonial Deposition

Applicant submitted 79 Cross Questions to Opposer's witness, Mr. Tetsuo Shimada. Opposer objected to almost every question on substantive grounds. Opposer did not raise any of these objections in its Trial Brief. According to TBMP Section 707.03(c), testimonial objections should be maintained in a party's brief, as explained in the following: Additionally, in order to preserve an objection that was seasonably raised at trial, a party should maintain the objection in its brief on the case. *See* TBMP Section 707.03(c); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief).

In light of the above, Applicant respectfully requests that the objects to Applicant's cross questions in Mr. Shimada's deposition (Shimada Dep.) be considered waived. If, for some reason, the objections are not waived, in spite of Applicant's belief that they have been, Applicant respectfully submits that all of its cross questions were admissible, proper, material, and relevant to the case at hand.